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IN THE

Supreme Court of the United States

October Term, 1968

No. 315

MASON HOFFENBERG,

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on April 23, 1968.

Citations to Opinions Below

There was no opinion in the District Court. The opinion of the Court of Appeals, printed in Appendix B hereto, is not yet reported officially but has appeared at 157 U.S.P.Q. 358.

Jurisdiction

The judgment of the Court of Appeals was entered on April 23, 1968. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

Questions Presented *

1. Under § 10 of the Copyright Act, must the publication with notice that secures copyright take place within the United States? (The Office contends that it must.)

2. Are the procedures described in § 22 and § 23 a mandatory and exclusive method of obtaining copyright in the circumstances mentioned in § 22 (as the Office contends) or do they provide a method alternative to that provided in § 10 (as the author contends)?

3. Do the provisions of § 16 apply without regard to whether the books are to be offered for sale in the United States or abroad (as the Office contends) or are they concerned only with the preservation of the United States market for United States manufacturers (as the author contends)?

4. Do the provisions of § 16 apply only to the manufacture of those copies that constitute the first publication of the work in question? (An affirmative answer is necessary to the Office position.)

5. If copyright was not secured by publication with notice abroad in 1958, was it nevertheless not lost (the principle of *United Dictionary Co.* v. *Merriam Co.*, 208 U. S. 260, controlling) so that copyright was secured by the 1964 publication in the United States?

6. Is Copyright Office Regulation § 202.4(b)(1) (which embodies the Office contentions referred to in the preceding questions) valid under the Act, and, if so, are §§ 16, 22 and 23, as thus construed and applied by the Office, unconstitutional under Article I, § 8, Clause 8 and Amendments I and V of the United States Constitution?

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* The petitioner will be referred to as "the author" and the respondent as "the Copyright Office" or "the Office".

7. Apart from what may be the proper ultimate disposition of the author's claims against alleged infringers, does the Office have discretion to deny registration of a claim to copyright on the basis of its own view of a fundamental question of law where the result of the Office action is to subject the claimant's substantive rights to the risk of obliteration—by operation of the statute of limitations—prior to a judicial determination of the existence or nonexistence of those rights?

Statutes Involved

The statutory provisions involved are §§ 10, 13, 16, 22 and 23 of the Copyright Act, 17 U.S.C. § 1 *et seq.*, Act of March 4, 1909, c. 320, 35 Stat. 1075, *et seq.*, as incorporated in the Act of July 30, 1947, c. 391, 61 Stat. 652, *et seq.* They are printed in Appendix A *infra.** Appendix A also contains the Copyright Office Regulation referred to (37 C. F. R., § 202.4(b)(1).

Statement

Petitioner is one of the two American authors of a novel written in English and first published in France in 1958 (JA 38).** Each copy of the work published abroad bears a copyright notice as required by the Act (JA 39). Each copy of the work published abroad was manufactured

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* The Copyright Act (17 U.S.C., § 1 *et seq.*) will hereinafter be referred to as "the Act" and its sections will be referred to hereinafter simply as "§ 10", § 13", etc. The addition of § 6 of the Act in 1947 (61 Stat. 654) raised the numbers of sections following it, so that the section presently designated § 10, for example, was § 9 of the Copyright Act of 1909, and similarly, § 22 was § 21. For convenience, the current numbering will be employed.

** The Joint Appendix filed in the court below has been designated as one of the items in the transcript of record for use on this petition, and references below designated "JA" are to that Appendix.

abroad (JA 38). No copy manufactured abroad was offered for sale in the United States by the authors or by anyone acting on their authority (JA 47). During the six-month period following first publication of the work abroad no steps were taken to effect compliance with § 22 (JA 38).

In May, 1964, G. P. Putnam's Sons published an edition of the work in the United States (JA 39). This has been the only publication of the work in the United States authorized by the authors (JA 47). All copies of the Putnam edition bear a copyright notice as required by the Act (JA 39). All copies of the Putnam edition have been manufactured in the United States (JA 47).

On March 11, 1965, the author, in accordance with § 13, mailed to the Copyright Office two copies of the American edition and an application for registration of a claim to copyright in the work under the provisions of § 10 (JA 7). The Office refused to register the claim to copyright on the ground that in its view copyright did not exist. By letter dated March 31, 1965 the Office cited Copyright Office regulation § 202.4(b), 37 C. F. R., as justification for its view, and took the position that in the circumstances copyright could be obtained only under the "ad interim" provisions, §§ 22 and 23 of the Act (JA 19). Section 202.4(b) has been in existence only since 1956, the Copyright Office prior to that time having taken the position that in circumstances like the present it would register the work. (The pertinent statutory provisions have not changed since 1909.)

In January, 1965, some eight months after the Putnam edition came out, infringing editions began to appear, and an action for copyright infringement was instituted by the authors and Putnam in the Southern District of New York (JA 48). In July, 1965 the action was dismissed without prejudice, on the ground that § 13 forbade the

maintenance of an action where a certificate of registration had not been issued (JA 48).

In May 1965 the author commenced this action for a judgment declaring that copyright had been secured in the work under the provisions of § 10 and directing the Copyright Office to accept copies of the work for deposit and to issue a certificate of registration in connection therewith (JA 1-6).* Cross-motions for summary judgment were made on the pleadings and on a stipulation of facts (JA 38-43). The District Court, without opinion, ordered that the author's motion be denied and the Office's motion be granted and that the action be dismissed. The Court of Appeals affirmed the orders, two judges joining in a *per curiam* opinion which relied upon the regulation and the third concurring without opinion.

Reasons for Granting the Writ

The Significance of the Case

The decision sought to be reviewed is a ruling upon an important question of federal law which has not been, but should be, decided by this Court. It is a question vexing to writers and publishers and much debated by practitioners and commentators, but, prior to this case, almost totally unexplored by the courts. It involves the meaning of § 10

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* The author had, alternatively, sought registration under § 22, despite the fact that no application therefor had been made within the period provided in that section. The author's contention was that the six-month period should be deemed to have been tolled. He based this on a letter from a Customs official stating that during the prescribed period (six months following the 1958 publication) the book would not have been admitted into the United States, so that the necessary deposit in the Copyright Office could not have been made. After the institution of the present action, the government made representations to the effect that a book addressed to the Office would have been forwarded by Customs, despite any ban that may have existed against general importation, and the author accordingly withdrew this additional claim.

of the Act (the basic copyright-securing provision) and its interrelations with § 13 (the registration provision), § 16 (the "manufacturing clause") and §§ 22 and 23 (the "ad interim" procedures). Clarification and resolution will be helpful to writers generally, to publishers (both authorized and unauthorized), and ultimately to the readers and (consequently) to the general public.

Even in the present case, judicial expression on the matter has been meager. The District Court wrote no opinion. In the Court of Appeals one judge concurred without opinion, and the laconic *per curiam* opinion says nothing about the fundamental problems of copyright law that the case presents. The decision rests entirely on the Copyright Office regulation. The regulation is itself merely a statement of the Office interpretation of the statute. The opinion does not examine the validity of that interpretation, and, we respectfully submit, cannot amount to more than the announcement of a conclusion. (It does, however, note the Office concession that the regulation is, at least in some of its applications, invalid.) This decision can hardly be expected to settle the matter for other Circuits.*

The petitioner is not alone in the specific situation in which he finds himself. Our anti-obscenity laws, before the First Amendment was held to limit their operation, compelled a number of gifted American authors to find publishers abroad. The work at bar has itself received serious and favorable critical attention.** There is much other

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* In the District Court, three extensive briefs were presented by each side, and in the Court of Appeals the author's main brief ran fifty-eight pages while the Office's ran sixty-six (excluding appendices). The length of the briefs—on both sides—was occasioned not by a failure to compress but by the complexity of the matter.

** See, e.g., *New York Sunday Times Book Review*, May 17, 1964; *Book Week*, May 17, 1964; *Life*, May 8, 1964; *Chicago Sun Times*, May 17, 1964; *Cleveland Plain Dealer*, June 14, 1964; *Newsweek*, December 21, 1964; *Boston Herald*, May 12, 1964.

writing, however, first published in similar circumstances, about whose importance there is broader consensus—the works of Henry Miller, Vladimir Nabokov, and J. P. Donleavy, for example.

Other situations involving the questions presented by this case keep coming up. American authors often have their works first published abroad in periodicals. This is typically writing of unquestioned political or scientific or literary value, but of doubtful commercial value. If the Office view is sustained, the author of such material is forced, on pain of losing his rights, to find a publisher who will undertake American manufacture and republication of his story, essay or poem, and within the limited period provided by the ad interim provisions—in most cases a hopeless undertaking. American photographers whose photographs and illustrators whose illustrations are offered first publication in other countries face the same dilemma.

Another group to whom the resolution of the issues presented by this case will be critical consists of distinguished European writers, now citizens of this country, who have continued to write in their native tongues. While § 22 refers only to works first published abroad in English, § 16, as interpreted by the Office, would also effect the forfeiture of works written in foreign languages unless the author first publishes an edition in the United States.* Even where such a work is translated into English, translations take time and are ordinarily not available until long after the original work is completed. The normal process would be to publish the work first in the country in whose language it is written, and then to publish a translated

* Section 16 contains an exception for works "of foreign origin in a language or languages other than English." The phrase "foreign origin" has been held to relate only to works by aliens, and the writers referred to here are American citizens.

version in the United States. The Office position makes this impossible; the author must either delay the publication of the original work until there is a translation and the translation can be given prior publication, or he must undergo the wasteful process of publishing a foreign-language token edition in the United States. And if his work does not have enough commercial value to warrant a token edition or translation-in-advance, the author is disabled from publishing his work among people likely to read it unless he is ready to sacrifice his copyright.

None of these classes of authors can find hope in the prospects (such as they may be) of new copyright legislation.* If anything, such legislation would magnify their loss—assuming the contentions made by the Office and sanctioned by the holdings below are correct—since the one change that seems to have drawn sufficient support for passage is an extension of the copyright term.** Such an enlargement of rights would apply only to subsisting copyrights. The works already shorn of protection (as the Office contention requires in the situations mentioned) could not benefit from the new legislation. And in any event, a new copyright act lies somewhere in the doubtful future.

Finally, unless the fact of "first manufacture" is given the vast and magic potency with which the Office—but not the language of the statute or its history—would endow it, the position taken by the Office in this case would forfeit copyright in all the greatest American literature of the

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* The *New York Times* for May 26, 1968, p. 15, under the heading "Copyright Law Revisions Are Put Off" reported:

> "A bill to modernize the nation's copyright laws was killed for this session of Congress this week, despite an intensive effort by the copyright office to save some of its noncontroversial aspects."

** Witness Congress's year-to-year prolongation of renewal terms about to expire in anticipation of such an amendment.

twentieth century. The Office does not carry its argument to this logical conclusion, but while it thus seeks to avoid an unthinkable result, the avoidance throws the statute itself into a state of insupportable illogic.

It is widely recognized that the manufacturing clause needs elucidation. The public importance of the provision and the turmoil it creates was recently emphasized by the Register of Copyrights himself. The newspaper report mentioned above contained, under the subhead "Two Changes Sought", the following:

> "Senator McClellan offered his substitute bill in spite of an appeal by Abraham L. Kaminstein, head of the Copyright Office, to include in the stopgap measure at least two changes that have won general acceptance. They are the extension of copyright protection for an author for life plus 50 years, instead of the present maximum span of 56 years, and relaxation of a *requirement that a book must be printed in this country to qualify for United States copyright protection.*
>
> "Mr. Kaminstein said he considered the adoption of these measures to be essential to help American authors and to restore confidence abroad in United States adherence to modern international standards." (New York Times, May 26, 1958, p. 15. Emphasis supplied.)

While new legislation might well be helpful, we submit that the existing Act is, in this respect, not as bad as the Copyright Office suggests. The statute does not require the unfortunate result for which the Office contends in the present case. The difficulty stems rather from the fact that, since 1956, the Office has advanced a mistaken construction of §§ 22 and 23 and (ultimately) of § 16, and has sought to codify that construction by making a regulation of it—a regulation which in the course of this litigation has been conceded to be (at least in certain areas) incompatible with the statute.

The Provisions of the Statute and the Opposing Interpretations

The author, having published his work with the notice required by the statute, claims copyright under § 10. The Office, applying its regulation and making the judgment that the author has no copyright (a judgment the statute appears to reserve, in the first instance as well as on review, to the courts) refuses to register his claim. The reason given is that, since first publication of the work took place abroad and the authors are American citizens, §§ 22 and 23 impose a mandatory and exclusive method of securing copyright. The Office takes this position despite the fact that under the plain language of § 10 the author appears to have secured copyright, and despite the fact that §§ 22 and 23 neither purport to override § 10 nor contain any language suggesting they provide anything other than an alternate route to copyright. The Office, however, finds in the provisions of § 16 implicit warrant for expanding the meaning of §§ 22 and 23 and reading a qualification into § 10.

Section 10 in its entirety is as follows:

> "§ 10. PUBLICATION OF WORK WITH NOTICE.—Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title."

The semi-colon breaks the section neatly in half. The first half has to do with securing copyright; the second half sets up a condition that must be met if the copyright secured is to be preserved. The first half of § 10 is unrestricted in its application; the second refers only to the United States. The explicit limitation in the second of the two cleanly separated parts of the section makes it impossible to read an implicit limitation into the first.

Section 10, which embodied a new approach to copyright, is the keystone provision in the Act. It is also an extraordinarily clear provision, one of the few precisely drafted sections in a statute noted for its ambiguities. And there is specific legislative history to show that its structure was deliberate and not fortuitous. When the bill which became the Act of 1909 was being considered, an earlier draft of § 10 provided that "any person entitled thereto by this Act may secure copyright for his work by publication thereof *in the United States* with notice of copyright required by this act." (Latman, *Howell's Copyright Law* (1962) p. 86. Emphasis supplied.) Congress changed this, and transferred the phrase "in the United States" to the second part of § 10. Thus, as originally drawn, the statute would have required that, in order to secure copyright, first publication (with notice) must take place in the United States, and the Office regulation would have been an accurate reflection of the statute. But before the bill became law, the requirement that the copyright-securing publication occur in the United States was deliberately rejected. There is nothing in § 10 as enacted that distinguishes between first publication in the United States and first publication abroad.*

The author has met the requirements of § 10. He has published his work with notice, thus establishing copyright under the first half of the section. Each copy of his work published or offered for sale in the United States by his authority has also contained the notice, so that the condition for preserving copyright has been fulfilled.

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* The "except" clause at the end of the section was at first relied on by the Office in its refusal to register the author's claim of copyright. The Office contended that the clause showed that § 22 constitutes a qualification of § 10 and that § 10 therefore does not operate in the situations described by § 22 (Office letter of March 31, 1965, ninth paragraph, J.A. 22.) The Office later abandoned this contention, conceding that the "except" clause belongs to the second half of § 10 and modifies only the portion of the section that follows the semi-colon.

The Act of 1909 (35 Stat. 1075), which with minor amendments constitutes our present copyright law, marked a fundamental departure from the prior statutory system. From the beginning until 1909, copyright was obtained by deposit and registration at or about the time of first publication; putting notice of copyright in the book was merely a precondition to suit for infringement (1 Stat. 124; 2 Stat. 171; 4 Stat. 436; 16 Stat. 212). (In the various acts, including the present one, Congress has chosen to distinguish between right and remedy.) For the first 119 years of our copyright history, copyright was achieved by going through a prescribed procedure involving the government. But for the past sixty years, a radically different method has been in force. The author no longer "takes out copyright" by engaging in certain actions with respect to an agency of the government. Instead, he gets it on his own, by actions that take place entirely apart from the government; he gets it by the simple act of publication with notice.

Thus in 1909 notice and registration switched roles: publication with notice became the key to copyright, while registration, under § 13, became the precondition to suit. Congress was quite conscious of the change it was making: S. Rept. No. 6187, 59th Cong. 2d Sess. (1907) p. 5; H. Rept. No. 7083, 59th Cong. 2d Sess. (1907) p. 8; S. Rept. No. 1108, 60th Cong. 2d Sess. (1909) p. 10. This Court emphasized the difference between the new system and the old in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30.

Section 13 contains the requirements for deposit and registration. Everything that happens under § 13, as its opening language states, takes place "After copyright has been secured by publication of the work with the notice of copyright as provided in section 10. . . ." The events that § 13 contemplates presuppose that copyright has been secured, and secured under § 10. The 1909 legislation as originally drafted (S. 6330; H. R. 19853 (1906)) did not

contain the quoted language; its later inclusion underscores its importance.*

Sections 22 and 23 in themselves contribute nothing to the solution of the questions this case involves. Nothing in these sections suggests that the procedure they provide is exclusive and mandatory, rather than an alternative (with certain advantages and disadvantages) that may be availed of. Nor is there anything in them to indicate an intent to modify the strong language of § 10. The Office, however, argues that § 16 prevents the author from securing copyright under § 10, and this being so, that §§ 22 and 23 provide the only possibility of achieving copyright. Thus the problem of statutory construction—affecting all six sections of the Act—turns on the meaning of § 10 and § 16.

Section 16 cannot operate if its terms are taken literally. On this petitioner and respondent agree.

If the terms of the section are taken literally, all the important American writing of the past half century would be without copyright protection. Neither the Office nor the author proposes such an interpretation. However, the interpretation relied on by the author, we submit, comports with general rules of construction, does no violence to the

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* A 1914 amendment to § 13 (38 Stat. 311) supplies further confirmation of the fact that § 10 grants copyright without regard to where the publication takes place. Referring to the requirement in § 13 that two copies of a work must be deposited, the amendment added the following:

> ". . . or if the work is by an author who is a citizen or subject of a foreign state or nation, and has been published in a foreign country, one complete copy. . . ."

Keeping in mind that the amendment did nothing except to reduce the number of copies that the foreigner need deposit, it is seen that publication abroad, with notice, is within the contemplation of § 10. The fact that the amendment refers to an alien does not alter the situation; if § 10 applied only to publication within the United States, this 1914 legislation would have no meaning.

language of the section, and conforms to an explicit Congressional policy. The interpretation offered by the Office, on the other hand, requires the reading into the section of what amounts to an amendment of its terms, and negates both the Congressional policy referred to (which will be documented below) and the general principle that statutory language is not to be bent to the purposes of pirates.

The author reads § 16 as concerned with the American market—a reading consonant with the protectionist purpose of the manufacturing clause. The Office reads § 16 as concerned only with first publication, not with subsequent publication—a reading consonant not with any Congressional policy but only with a prior statutory mechanism that was superseded in 1909.

Ignoring its explicit exceptions (which do not apply to the issues of principal concern), § 16 requires that "the text of all copies accorded protection under this title" be printed and bound in the United States. An unqualified reading of § 16 would lead to the conclusion that if any copy of a work were manufactured aboard, that copy could not be protected by copyright. It would follow that anyone could make further copies from that copy—that is, bring out his own edition of the work—without paying royalties to its writer, no matter how punctilious the writer's compliance with other requirements of the Act. The result would be that every outstanding American literary work of the twentieth-century would have lost protection early in its copyright period. This is because all these works have been published in Great Britain, and the British editions have been manufactured by British printers and binders. The pirate would have only to use a copy of the British edition as the basis for his piracy.

It thus appears that § 16 cannot be given the shotgun construction that its words might suggest. No one—not the boldest pirate—has sought, without authority from the

copyright proprietor, to publish the works of Dreiser, Faulkner, Hemingway, Lewis, *et al.*, on the theory that the printing of a work outside the United States—a literal negation of the naked terms of § 16—in itself forfeits United States copyright protection.

Section 16 could hardly have been intended to have such an effect. And in fact it was not. The well-established canon of construction that a statute is not to be given extra-territorial application unless the legislative purpose to do so is clear (*United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260 and cases there cited) suggests that the requirement of domestic manufacture is not meant to extend to events that have no contact with the United States—the foreign manufacture of books for foreign markets. But it is not necessary to rely on abstract canon. There is in the history of the statute conclusive evidence that Congress enacted the manufacturing clause as a means of encapsulating the American market, and had no concern with the manufacture of books that would not be fed into the domestic economy. Section 16 is a protectionist provision, designed to preserve the American market for American printers and binders. (See Congressional documents cited below at pages 18-20).

The Office puts a different gloss upon § 16. It rejects any distinction based on the stated Congressional concern, and instead offers one based on time of manufacture. The requirements of the section, the Office contends, apply only to the first manufacture of a work, and not—though the statute makes no mention of any such exemption—to subsequent printings. Hence, says the Office, this author must lose his copyright because the first edition of his work was printed abroad, while those authors are safe who have editions printed abroad other than the very first. This distinction is not supported by any language contained in § 16 or in any other provision of the Act, nor by any social or economic goal that can be discerned in the Act itself or in extrinsic evidence of Congressional intent. It represents

a confusion of the pre-1909 copyright law with the present law, a confusion planted by early treatise-writers and allowed to take hold in absence of judicial treatment of the subject. It was occasioned by the fact that the first manufacturing clause came into the law in 1891, under the altogether different mechanism for obtaining copyright that existed prior to 1909. The Office position is imported from a statutory system deliberately abandoned by Congress.

The Genesis of the Manufacturing Clause.

In 1891 the benefit of United States copyright was for the first time extended to aliens. This was not a matter of generosity; Congress wanted to protect American authors whose works were published in Great Britain, and to accomplish this it was necessary to grant reciprocal rights to British authors. However, there had been a thriving business in this country built upon the royalty-free publication of British works, and Congress felt obliged to compensate American printers for the loss of this business. At the same time, Congress wanted to protect American printers from having their market diluted by books printed aboard. To attain these objectives, Congress did two things: (1) it forbade the importation of foreign-manufactured books; and (2) by making a slight but effective change in the then-existing process of securing copyright, it created an inducement to manufacture in the United States.

Prior to 1909, as we have mentioned, copyright was secured by depositing copies and registering the work at the time of initial publication. The device to promote American manufacture employed those provisions; the copies that had to be deposited were required to be copies of American manufacture, and the deposit had to be made "on or before the day of publication in this or any foreign country. . ." (26 Stat. 1107). The practical effect was to deny American copyright to works first published abroad. It was conceiv-

able that a British publisher might manufacture two copies of the author's work in this country and deposit them prior to publication, but such an undertaking was hardly likely. Hence if a British author or publisher wanted to obtain United States copyright, American manufacturers could count on his printing an entire edition in the United States and depositing two of the copies so printed.

Thus, for a brief period in the history of our copyright law—a period of eighteen years—the position now taken by the Office would have conformed to the statute. Publication having taken place prior to the deposit of American-made copies, the benefit of American copyright would have been denied to the author. Under the present act, however, the position is utterly out of joint with the statute. The securing of copyright now has nothing to do with the deposit of copies. It flows directly from publication with notice. And deposit and registration can take place any time prior to suit.

This is not to say that in 1909 Congress lost interest in benefiting American printers. On the contrary, it maintained that interest, and developed a new protective mechanism, one that was consonant with the new method of securing copyright but served the same ultimate objectives. Since deposit of copies no longer had anything to do with establishing copyright, it would not matter (for that purpose) whether or not the author had American-made copies to deposit. Hence, in place of the now-anachronistic device of tying American manufacture to the copyright-securing process, Congress made two provisions: (a) it enacted a new manufacturing clause, § 16; (b) it shifted the requirement that the copies deposited be of American manufacture to § 13 (where it would have no effect on obtaining copyright but would be a precondition to suit for infringement).

Congress also continued the ban on importation of foreign-made copies, in § 107.*

Whatever other ambiguities the section may contain, it is plain that § 16 does not purport to form any part of the copyright-securing process. Nor, we submit, does it require a subsequent forfeiture, so long as every copy offered for sale in the United States is manufactured in the United States.** From the beginning, Congress made it clear that the manufacturing clause was directed only to preserving the American market for American printers, and the Congressional purpose has never changed. The Senate report on the 1886 bill that eventually became the Act of 1891 stated:

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*The ad interim provisions first came into the law when the 1891 statutory scheme was in effect; their aim was to provide some relief from the necessity of printing an American edition before the work could be published in its homeland (if the opportunity to achieve American copyright under the Act of 1891 was not to be lost). (Act of 1904, 33 Stat. 4; Act of 1905, 33 Stat. 1000.) In 1906 the major overhauling of the copyright law that was to produce the Act of 1909 began. Since the Act of 1905 referred only to works written in foreign languages, British authors asked that they too be given relief (H. Rept. No. 2222, 60th Cong. 2d Sess. (1909)). Congress obliged them with the present § 22, but by the time the provision became law in 1909, the copyright-securing system was entirely different from what it had been when the British authors made their request. Despite the fact that the provision was directed to the British authors' problem, its language was broad enough to take in the then-extraordinary situation of an American author publishing abroad. Much later, with the adoption of the Universal Copyright Convention, § 22 became virtually a dead letter for British authors. Its impact now is almost entirely upon American authors—a consequence that would surely have startled the Congress that enacted the provision. To go further, and construe the section as an occasion for deprivation of American rights, would have seemed to that Congress preposterous. We refer to the committee report cited above and to the other Congressional documents that appear below.

**There is now an exception for fifteen hundred copies of foreign manufacture, which may be imported if the author has chosen to proceed via the ad interim provisions.

> "... The foreign author cannot complain, because we give him protection in our market conditioned only that he publish here. The American artisan will be insured *only that which he now possesses*, the labor put upon the publication of foreign books. ..." (S. Rept. No. 1188, 49th Cong., 1st Sess. (1886) p. IV. (Emphasis supplied.)

The American artisan, of course, had not been doing the printing of books that had been published abroad for sale abroad.

During the committee hearings, James Welsh, representing the Typographical Union, was questioned by the chairman:

> "The Chairman: . . . that you are in favor of international copyright, *provided all books of foreign authors published in this country* copyrighted here, shall be published in American houses?
>
> Mr. Welsh: Yes, under the copyright law; that they shall have permission to publish foreign books by coming here and taking out an international copyright, and having their work done on this continent." (Hearings before the Committee on Patents, 49th Cong., 1st Sess. (1886) p. 5. (Emphasis supplied.)

Congress was also concerned about the detriment to American authors and publishers caused by the sale of foreign works in the United States at prices cheaper than those of American books. But here, also, it was only the American market that Congress had in view. At the same hearings, the publisher Henry Holt, after stating the problem, said

> "It follows, then, that an American author, to compete with the cheap foreign reprints must . . . publish at a cheap price himself . . ." (Id., p. 12.)

Senator Platt, one of the sponsors of the 1891 legislation, made the purpose plain on the floor of the Senate:

> "First, however, I will say a word about the clause in our copyright law as proposed by the bill which

> favors the persons who produce books in this country, the men who set the type and perform the labor. I see no injustice whatever—on the other hand, I see great justice—in confining to this country the production of works *which are to be sold in this country. . . .*" (22 Cong. Rec. 2604.) (Emphasis supplied.)

And:

> "We simply make an equitable arrangement that *if a foreign work is to be circulated here,* it is to be printed and bound here." (22 Cong. Rec. 2605.) (Emphasis supplied.)

In these circumstances, subsequent legislative materials may have some slight value in confirming what the actual legislative history (which precedes enactment) already appears to demonstrate. Senate Report No. 375, 81st Cong., 1st Sess. (1949) p. 4, repeating in substance House Report No. 238 (to accompany H.R. 2285), stated: ". . . the repeal of the manufacturing clause would result in the flooding of *the American market* with the products of cheap foreign labor." (Emphasis supplied.) The settled view of the matter is expressed in a letter from the Secretary of State to the Chairman of the Senate Committee on the Judiciary, incorporated in the same Report:

> ". . . the various provisions of title 17 described above are clearly designed to preclude any book in the English language from having copyright protection in the United States unless, with a few exceptions, every copy *sold here* is manufactured in the United States." (Emphasis supplied.)

Moreover, the House Committee Report on the copyright legislation currently before Congress states:

> "The basic purpose of section 601, *like that of the present manufacturing clause,* is to induce the manufacture of an edition in the United States *if more than a certain limited number of copies are to be distributed in this country. . . .*" (H.R. Rept. No. 83, 90th Cong., 1st Sess (1967) p. 135.) (Emphasis supplied.)

The statutory pattern was fundamentally altered by the Act of 1909, but the Congressional purpose that lay behind the manufacturing provision of 1891 also lay behind the quite different manufacturing provision of 1909. As the hearings, reports and debate had made clear, that purpose was to maintain for American printers the trade they had enjoyed in connection with books by foreign authors—that is, the work of printing for the American market—and to prevent the flooding of the American market with books of foreign manufacture. Congress was seeking to preserve, and if possible, to enlarge, the American market for American printers. Congress was not seeking to create a monopoly in overseas markets for our printers. It was altogether outside the contemplation of Congress that it should use the occasion to invent a new business of printing for overseas markets, and that it should establish the new business by imposing burdens on American authors. Yet it is this unlikely, and, we submit, non-existent, legislative intent that must be posited if the Copyright Office thesis is to be accepted.

The Office contention—that the market for which the manufacture is done is irrelevant, and that copyright protection turns on whether we are dealing with the first edition or with subsequent editions—bears no relation to (except as it contradicts) these plainly stated Congressional purposes. Nor does the contention permit a coherent construction of the several provisions of the Act. Indeed, the Office has conceded that the regulation which it has applied in this case conflicts with the Act in at least one important instance—a concession which, we submit, amounts to an admission of invalidity. In the course of the litigation below, counsel for the author presented the following situation: There is to be American and British publication of a work by an American author; all copies of the work, both those to be sold in the United States and those to be sold in Great Britain, are manufactured in the United

States; the number required for British distribution is shipped to England; and publication of the work takes place in Great Britain before it takes place in the United States. Counsel for the Office conceded that even though first publication had taken place abroad, and the ad interim procedures were not followed, such a work would receive copyright protection under the Act (assuming, of course, that it contained the proper copyright notice). The Office regulation states the exact contrary.*

As we have indicated, there is no judicial authority (except the decisions below) directly in point. However, the author's position is consistent, and the Office position is inconsistent, with the fundamental view of the Act of 1909 —and specifically of the effect of § 10—taken in *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, and in *Heim* v. *Universal Pictures Co.*, 154 F.2d 480 (2 Cir.).

The "Legislative History" Offered by the Copyright Office

The arguments made by the Office in the courts below were grounded on what the Office called "legislative history" (apart from some treatises which themselves supply no other authority). But this consists entirely of statements about the presumed meaning of §§ 16, 22 and 23 made long after those sections became law. The Congressional intent that courts consult is, necessarily, the contemporaneous intent of the legislators who enacted the statute. The legislative history of the provisions governing the present

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* The concession appears in Transcript of Proceedings in the District Court, p. 25, and in Defendant's Brief after Hearing in the District Court, p. 8. It was repeated in the argument before the Court of Appeals.

Printing in the United States for both American and British publication is already taking place in connection with periodicals. The trend is likely to accelerate in view of the widening "technological gap". Technological advances in this country in duplicating and electronic printing techniques have been particularly rapid.

case was complete in 1909. Statements by legislators speaking decades later (such as the Office cites)—even latter-day statements by those who had a hand in the passing of the bill (such as those rejected in certain cases cited below)—are not legislative history in any pertinent sense.

What the Office relies on is nothing more than what individual Congressmen think to be the meaning of provisions already on the books (or, more realistically, what some lawyer on a Congressional staff, reading secondary authorities, thinks they mean). Retrospective comment on existing statutes where there is no re-enactment is not legislative history. It is at best legal opinion. *United States* v. *Wise*, 370 U.S. 405; *United States* v. *Philadelphia National Bank*, 374 U.S. 321; *United States* v. *Price*, 361 U.S. 304; *Waterman Steamship Corp.* v. *United States*, 381 U.S. 252, and cases cited therein.

In the Court of Appeals, the Office replied that the statements on which the Office relies were made in connection with "successful amendatory legislation." The reply would be pertinent if it was one of the amendments itself whose interpretation were in issue, and if the legislative statements on which the Office bases its argument were statements as to the meaning of the amendment. Such was the situation in the two cases cited by the Office: *United States* v. *Zachs*, 375 U.S. 59 and *Flora* v. *United States*, 362 U.S. 145. But the amendments of 1919 and 1949, in connection with which the statements cited by the Office were made, have no relevance. So far as the issue of the present case is concerned, the provisions of the Act of 1909 were left utterly unaffected by the amendments.* The Office's argument simply does not

*Section 10 is exactly the same now as it was in 1909. With respect to § 22, the amendments merely extended the time periods specified, and did not touch the section's applicability. Similarly, the amendment of § 16 merely conferred an additional benefit on authors who choose to employ the ad interim procedures (allowing importation of 1,500 copies) and did not affect the scope or applicability of the manufacturing requirement.

meet the basic reasoning of the cases listed in the preceding paragraph, which is that "... statutes are construed by the courts with reference to the circumstances existing at the time of the passage...." (*United States* v. *Wise,* 370 U.S. 405, 411) and that "[T]he views of a subsequent Congress form a hazardous basis for inferring the intent of an earlier one." (*United States* v. *Price,* 361 U.S. 304, 313.)

The Question Raised by United Dictionary v. Merriam

The material above has to do with the question whether copyright was attained by the 1958 publication abroad. The case also raises the question whether, if it was not attained by that publication, it was nevertheless not lost, and was eventually secured by the 1964 publication in the United States. This question involves an interpretation of *United Dictionary Co.* v. *Merriam Co.,* 208 U.S. 260, in which this Court held that the notice required under the statute then in force was not required on books published and sold abroad. The reasoning of *United Dictionary,* we submit, would apply as well to the requirements of the manufacturing clause. The broad principle the case stands for is that rights will not be deemed forfeited by events or transactions taking place outside the United States unless Congress has manifested an explicit intent that they should be thus forfeited. There is no such explicit expression in the Act.

The Question Whether the Office Interpretation and Regulation is Entitled to Presumptive Weight

The fact that the Office is an administrative agency does not entitle its interpretation of the statute, in the present circumstances, to any consideration beyond that allowed the arguments of an ordinary litigant. The questions is purely one of law, a question as to which the courts are obliged to give no deference to the views of the Copyright Office. With all the respect due to the Register and his

staff, they bring to the present question no more than other good advocates would bring. This situation has nothing in common with those in which the presumption of administrative regularity has been developed. The present case is one for judicial, not administrative, expertise. Cf. *Grove Press* v. *Christenberry,* 275 F.2d 433 (2 Cir.).

The point is not affected by the fact that the particular view of the law the Office espouses finds formal expression in a regulation. Factors that in proper circumstances entitle an administrative regulation to presumptive validity are not present here. There are other aspects of the statute as to which the Office has a more active function, but the securing of copyright is a matter determined entirely by events in which the Office plays no part. *Washingtonian Publishing Co.* v. *Pearson,* 306 U.S. 30. The Act does not in this regard assign the Office "the task of implementing and enforcing the statute" (Davis, *Administrative Law Treatise,* Vol. 1, § 5.11). The Office has no responsibility for granting or withholding copyright.

Nor is there a background in the problems of making a regulatory statute work, or any corpus of technical non-legal knowledge, that would entitle the Office to claim a clearer view of the present legal question than that of any other litigant. This is not the S.E.C. dealing with securities markets, or the C.A.B. with airline routes, or the F.C.C. with broadcasting licenses.

Nor is the position that the Office has embodied in its regulation "a contemporaneous and long-continued construction of the statute . . ." (*Mazer* v. *Stein,* 347 U.S. 201, 213). On the contrary, for half a century after the statute was enacted the interpretation placed upon it by the Office was the contrary of the interpretation the Office now seeks to impose. The current regulation was promulgated in 1956. Until then a claim to copyright such as this author has made would have been registered and a certificate issued (Howell, *The Copyright Law,* 3rd Ed. (1952) pp. 99-100).

The Constitutional Problems

The construction proposed by the Office raises constitutional problems. Putting an unnecessary burden on authors, it negates the purposes expressed in Article I, § 8, Clause 8. Those purposes may, of course, conflict with other permissible acts of Congress, and the advancement of printers' interests may constitutionally justify a diminution of authors' rights. Thus § 16, to the extent that its language and clear evidence of Congressional intent carries it, is not challenged. But there is no justification for expanding it further—as the Office does—to gain a dubious advantage for printers by derogating from the public interest announced in Clause 8. And in fact the Office interpretation does not benefit American printers. On the contrary, its interpretation requires either that the author employ the ad interim procedures, under which 1,500 foreign-made books may be brought in, or that the work be left unprotected, so that pirated editions may be manufactured abroad and freely imported into the United States—in either case a diminution of the business available to American printers. (Section 107, barring importation, applies only "During the existence of the American copyright . . . ") If, on the other hand, the American author secures copyright when he publishes (with notice) abroad, the American printer is indeed benefited: any copies that come onto our market must be American-made.

The present case supplies a concrete example. G. P. Putnam's Sons, on the writers' warranty of copyright, undertook American publication of the work. To preserve the copyright, this edition for the American market had to be (and was) manufactured here. If there were no copyright to protect, Putnam's might have manufactured the books more cheaply abroad—in Italy, or Holland—and then shipped them into this country. In contrast, the books put out by the infringers against whom the author wishes to proceed are made up of an exact page-by-page,

line-by-line duplication of the author's foreign edition—an evident reproduction by photocopy, demonstrating that American printers had no hand in the manufacture of the infringing books. These two aspects of the situation thus illustrate the fact that the Office regulation, while it injures the author, does so only for the sake of the pirate, and gains nothing for—indeed does harm to—the American printer in whose aid the manufacturing clause was enacted.

A second problem arises under Amendment V. The effect of the Office position is to discriminate not only against authors so situated as compared with other American authors, but also against American authors generally as compared with foreign authors. By reason of the Congressional ratification of the Universal Copyright Convention (in § 9 of the Act), a foreign author would, in the same circumstances, have his work protected. Even if such an incredibly xenophilic approach could be attributed to Congress, it would involve a denial of equal protection, and therefore a violation of the due process guaranteed by the Fifth Amendment. Cf. *Schneider* v. *Rusk*, 377 U.S. 163; *Bolling* v. *Sharpe*, 347 U.S. 497. It may be observed, from the excerpts quoted above at pages 18-20, that the manufacturing clause was regarded by the Congress that enacted it as something that would operate against foreigners.

Third, the combination of hardship and complexity that the regulation imposes upon authors amounts to an impairment of free expression and thus violates the guarantees contained in the First Amendment. Cf. *Dombrowski* v. *Pfister*, 380 U.S. 479; *Memoirs* v. *Massachusetts*, 383 U.S. 413.

The Question Whether, Without Regard to the Merits, the Claim Should Be Registered

In addition, apart from whether the author has or has not secured copyright, the case presents the question whether the Office has discretion to deny registration of

the claim to copyright in a matter of this kind. There are situations in which the Office may properly decline to accept deposit and issue a certificate, but they have little in common with the present case. The decisions supporting discretion have to do with the problem, frequently faced by the Office, whether the object or article as to which registration is sought constitutes copyrightable subject matter. Cf. *United States ex rel. Everson* v. *Young*, 26 Wash. L. Rep. 546 (Sup Ct. D.C.); *King Features Syndicate* v. *Bouve*, 748 U.S.P.Q. 237 (D.C.D.C.); *20th Century Fox Film Corp.* v. *Bouve*, 33 F. Supp. 462 (D.C.D.C.), affd. 122 F.2d 51 (D.C. Cir.); *Brown Instrument Co.* v. *Warner*, 161 F.2d 910 (D.C. Cir.); *Bailie* v. *Fisher*, 258 F.2d 425 (D.C. Cir.). To some extent, of course, these situations require an interpretation of the Act, but there is a critical difference of degree. In the cases cited, the question is mainly factual; a discrete portion of the statute is involved, and the problem has to do with its application to varying concrete fact-situations. In the instant case, in contrast, the facts are plain and uncontroverted, while the question of law is complex and involves the core of the statutory structure.*

There are no administrative considerations requiring that an adjudication of the author's substantive rights be preceded by litigation with the Copyright Office over whether a certificate should issue. There are no housekeeping factors, such as those that might lead the Office to refuse deposit of objects difficult to store or handle. There is no enforcement policy at stake here, such as a regulatory agency might be concerned with. The issuance of the certificate can have no final consequence except to insure that

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* The scope and meaning of cases upholding Office action with respect to registration must be considered in the light of the purpose that grants the authority: "Section [207] provides for the making of rules and regulations and does not confer upon the register any judicial functions." (H. R. Report No. 2222, 60th Cong., 2d Sess. (1909) p. 20.)

the author's rights be determined according to whether he has copyright in his work, and not according to whether the statute of limitations may have run. The issuance of the certificate prejudges no one's rights. It simply permits the question whether the author has a valid copyright to be litigated in the forum in which the Act contemplates it will be litigated—a federal district court.

American authors who come within the scope of a regulation which (to some extent at least) is concededly in conflict with the Act are denied rights enjoyed by their fellow citizens. Perhaps even more remarkable, they are denied these rights in precisely the same circumstances in which the rights are granted to aliens.

It is not as though so bizarre a result were compelled by clear statutory expression. On the contrary, the result below cannot be reached unless the statutory language has engrafted upon it an unexpressed proviso, a silent and arbitrary distinction between first manufacture and all subsequent manufacture. This is not even a situation where, with language less than clear, a discoverable legislative purpose requires an unfortunate harsh result. Here the protectionist policy that Congress sought to further is not served by the Office gloss upon the Act; on the contrary, as we have mentioned, American printers do not gain but rather stand to lose by it. Meanwhile, Congress has attributed to it the astonishing objective of bestowing benefits upon the foreign writers which it would withhold from citizens.

The "exclusive right" that the Constitution gives Congress power to grant to authors is not to be extended beyond the area in which Congress means to grant it. But Congress, in § 10, clearly marked the area in which the right is to be granted; it is to be granted where there is

publication of an original work with the required notice, without regard to whether the publication takes place in the United States or abroad. That has happened here. The rest is a question of forfeiture, and forfeiture is not to be lightly inferred. The Copyright Act has always been construed so as to encourage our writers to produce, by securing them in their copyright and denying to pirates "the fruits of piracy" (See *Ferris* v. *Frohman*, 223 U.S. 422, 437). If this general principle is to be abandoned here—if the grant in § 10 is to be regarded as qualified even though there is no statutory language qualifying it, nor any evidence of a countervailing Congressional policy that would demand its qualification—the step should not be taken without consideration of the matter by this Court.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

CHARLES REMBAR,
MORTON E. YOHALEM,
Attorneys for Petitioner.

APPENDIX A

Appendix of Statutes and Regulation

Pertinent sections of the United States Copyright Law, Act of March 4, 1909, c. 320, 35 Stat. 1075, et seq., as incorporated in the Act of July 30, 1947, c. 391, 61 Stat. 652, et seq., Title 17 U.S.C.:

Section 10 (61 Stat. 656): PUBLICATION OF WORK WITH NOTICE.—Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.

Section 13 (61 Stat. 656, as amended): DEPOSIT OF COPIES AFTER PUBLICATION; ACTION OR PROCEEDING FOR INFRINGEMENT.—After copyright has been secured by publication of the work with the notice of copyright as provided in section 10 of this title, there shall be promptly deposited in the Copyright Office or in the mail addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, or if the work is by an author who is a citizen or subject of a foreign state or nation and has been published in a foreign country, one complete copy of the best edition then published in such foreign country, which copies or copy, if the work be a book or periodical, shall have been produced in accordance with the manufacturing provisions specified in section 16 of this title; * * * No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with re-

spect to the deposit of copies and registration of such work shall have been complied with.

Section 16 (61 Stat. 657, as amended): MECHANICAL WORK TO BE DONE IN UNITED STATES.—Of the printed book or periodical specified in section 5, subsections (a) and (b), of this title, except the original text of a book or periodical of foreign origin in a language or languages other than English, the text of all copies accorded protection under this title, except as below provided, shall be printed from type set within the limits of the United States, either by hand or by the aid of any kind of typesetting machine, or from plates made within the limits of the United States from type set therein, or, if the text be produced by lithographic process, or photoengraving process, then by a process wholly performed within the limits of the United States, and the printing of the text and binding of the said book shall be performed within the limits of the United States; which requirements shall extend also to the illustrations within a book consisting of printed text and illustrations produced by lithographic process, or photoengraving process, and also to separate lithographs or photoengravings, except where in either case the subjects represented are located in a foreign country and illustrate a scientific work or reproduce a work of art: *Provided, however,* That said requirements shall not apply to works in raised characters for the use of the blind, or to books or periodicals of foreign origin in a language or languages other than English, or to works printed or produced in the United States by any other process than those above specified in this section, or to copies of books or periodicals, first published abroad in the English language,

imported into the United States within five years after first publication in a foreign state or nation up to the number of fifteen hundred copies of each such book or periodical if said copies shall contain notice of copyright in accordance with sections 10, 19, and 20 of this title and if ad interim copyright in said work shall have been obtained pursuant to section 22 of this title prior to the importation into the United States of any copy except those permitted by the provisions of section 107 of this title: *Provided further,* That the provisions of this section shall not affect the right of importation under the provisions of section 107 of this title.

Section 22 (61 Stat. 659, as amended): AD INTERIM PROTECTION OF BOOK OR PERIODICAL PUBLISHED ABROAD.—In the case of a book or periodical first published abroad in the English language, the deposit in the Copyright Office, not later than six months after its publication abroad, of one complete copy of the foreign edition, with a request for the reservation of the copyright and a statement of the name and nationality of the author and of the copyright proprietor and of the date of publication of the said book or periodical, shall secure to the author or proprietor an ad interim copyright therein, which shall have all the force and effect given to copyright by this title, and shall endure until the expiration of five years after the date of first publication abroad.

Section 23 (61 Stat. 659, as amended): SAME; EXTENSION TO FULL TERM.—Whenever within the period of such ad interim protection an authorized edition of such books or periodicals shall be published within the United States, in accordance with the manufacturing provisions specified in section 16 of this title, and whenever the provisions of this title as to deposit

of copies, registration, filing of affidavits, and the printing of the copyright notice shall have been duly complied with, the copyright shall be extended to endure in such book or periodical for the term provided in this title.

Section 107 (61 Stat. 663): IMPORTATION, DURING EXISTENCE OF COPYRIGHT, OF PIRATICAL COPIES, OR OF COPIES NOT PRODUCED IN ACCORDANCE WITH SECTION 16 OF THIS TITLE.—During the existence of the American copyright in any book the importation into the United States of any piratical copies thereof or of any copies thereof (although authorized by the author or proprietor) which have not been produced in accordance with the manufacturing provisions specified in section 16 of this title . . . is prohibited. . . .

Section 9 (61 Stat. 655, as amended): AUTHORS OR PROPRIETORS, ENTITLED: ALIENS.—The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title: *Provided, however,* That the copyright secured by this title shall extend to the work of an author or proprietor who is a citizen or subject of a foreign state or nation only under the conditions described in subsections (a), (b), or (c) below:

* * * (b) When the foreign state or nation of which such author or proprietor is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States the benefit of copyright on substantially the same basis as to its own citizens, or copyright protection, substantially equal to the protection secured to such foreign author under this title or by treaty; . . .

> * * * (c) When the Universal Copyright Convention, signed at Geneva on September 6, 1952, shall be in force between the United States of America and the foreign state or nation of which such author is a citizen or subject, or in which the work was first published. Any work to which copyright is extended pursuant to this subsection shall be exempt from the following provisions of this title: . . . (3) the provisions of sections 14, 16, 17, and 18; (4) the import prohibitions of section 107, to the extent that they are related to the manufacturing requirements of section 16; . . .
>
> * * * The provisions of this subsection shall not be extended to works of an author who is a citizen of, or domiciled in the United States of America regardless of place of first publication, or to works first published in the United States.

Regulations of the Copyright Office, 37 C. F. R., issued under authority of 17 U. S. C. § 207 (61 Stat. 666):

> § 202.4 *Books (Class A).* * * * (b) *Ad interim registrations.* (1) An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered unless an ad interim registration is first made.

APPENDIX B

(Opinion of the U. S. Court of Appeals for the District of Columbia)

UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 21,152

MASON HOFFENBERG, Appellant

v.

ABRAHAM L. KAMINSTEIN, Register of Copyrights, Appellee

Appeal from the United States District Court for the District of Columbia

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Decided April 23, 1968

Mr. Charles Rembar, of the bar of the Court of Appeals of New York, *pro hac vice,* by special leave of court, with whom *Mr. Morton E. Yohalem* was on the brief, for appellant.

Mr. Michael W. Werth, Attorney, Department of Justice, with whom *Assistant Attorney General Edwin L. Weisl, Jr., Messrs. Morton Hollander* and *T. Hayward Brown,* Attorneys, Department of Justice, and *Miss Dorothy Schrader,* Attorney, United States Copyright Office, were on the brief, for appellee. *Mr. John C. Eldridge,* Attorney, Department of Justice, also entered an appearance for appellee.

Opinion of the U. S. Court of Appeals for the District of Columbia

Mr. Stanley L. Temko filed a brief on behalf of the Authors League of America, Inc. as *amicus curiae* urging reversal.

Mr. Ben Cohen filed a brief on behalf of Lancer Books, Inc. *as amicus curiae* urging affirmance.

Before WILBUR K. MILLER, *Senior Circuit Judge*, and BURGER and WRIGHT, *Circuit Judges*.

PER CURIAM: Appellant and Terry Southern, both American citizens, are co-authors of the novel "Candy" which was first printed and published in the English language in France in 1958 with the appropriate statutory copyright notice. *See* 17 U.S.C. §§ 19 and 20 (1964). On March 11, 1965, more than six years after first publication of the foreign edition in France, appellant submitted to appellee an application for registration of a claim to ad interim copyright in the foreign edition. On the same date he submitted an application for registration of a claimed copyright in an American edition of "Candy" which was substantially the same text as the French edition. On March 31, 1965, the Copyright Office refused to register either the claimed ad interim copyright for the French edition or the claim to copyright in the American edition, stating as its reason failure to comply with the provisions of Sections 16[1], 22[2] and 23 of the Copyright Code, 17 U.S.C. §§ 16, 22, 23 (1964). On June 25, 1965, appellant filed the present action in the District Court to compel the Register of Copyrights to issue a certificate of registration covering only the 1964 American edition. On cross-motions for summary judgment, the District Court granted the Register's motion, denied appellant's motion, and dismissed the action.

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[1] Section 16 requires generally that, for an English-language book to be *registered for copyright* in the United States, it must be printed in the United States.

[2] Section 22 requires that the application for ad interim copyright of a foreign edition of an English-language book be made within six months after publication abroad.

Except when the ad interim provisions of Sections 22 and 23 are met, Section 16 of the Copyright Code allows copyright registration of English-language books by United States citizens only where the first publication is printed in the United States. Implementing these provisions of the Copyright Code pursuant to 17 U.S.C. § 207 (1964), in 1956 the Register of Copyrights promulgated the following regulation:

> "*Ad interim registrations.* (1) An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered unless an ad interim registration is first made." 37 C.F.R. § 202.4(b)(1967).

Since the novel "Candy" was first published and printed[3] abroad in the English language and there is no ad interim registration of that edition, registration of the American edition was properly refused.

A regulation, of course, is presumptively valid and ordinarily should be upheld unless it is inconsistent with the statute. *New York Foreign Freight Forwarders & Brokers, Ass'n* v. *F.M.C.*, 2 Cir., 337 F.2d 289, 295 (1964), *cert. denied*, 380 U.S. 910, 914 (1965). The above regulation is not only not inconsistent with the pertinent sections of the Copyright Code, but in our judgment it accurately reflects the intention of Congress. *Compare United States* v. *Zasove*, 334 U.S. 602, 611 (1948). Even if there were some doubt, we would be required to resolve that doubt in favor of the Register's interpretation. *Udall* v. *Tallman*, 380 U.S. 1, 16 (1965).

Affirmed.

Circuit Judge BURGER concurs in the result.

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[3] Appellee concedes that, where a foreign edition is printed in the United States, a subsequent American edition may be registered without compliance with the ad interim provisions of 17 U.S.C. §§ 22 and 23.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 315

MASON HOFFENBERG,

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF OF THE AUTHORS LEAGUE OF AMERICA, INC. *AS AMICUS CURIAE*

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IN THE

Supreme Court of the United States

October Term, 1968

MASON HOFFENBERG

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, Register of Copyrights,

Respondent.

BRIEF OF THE AUTHORS LEAGUE OF AMERICA, INC. *AS AMICUS CURIAE*

Interest of the Authors League

The Authors League of America is a national society of professional writers. It files this brief in support of the Petition, with the consent of the parties, because the question involved is of gravest importance to many American authors. If the Copyright Office interpretation of Sec. 16 of the Copyright Act. (17 U.S.C. 16) is allowed to stand, it would deprive American authors of United States copyrights in several books of enduring literary value which were first published abroad during the last six decades.

Summary of Argument

The Authors League respectfully submits that the Petition should be granted. It presents an important question

under the Copyright Act, and the decision below, if not reversed, would cause great injury to writers who have made valuable contributions to the literature of this country and the world—without any purpose except to inflict that injury.

The Circuit Court's decision sustaining the Copyright Office construction of Sec. 16 should be reviewed and reversed. That construction is wrong. Moreover it so unjustifiably and senselessly discriminates against American book authors, and constitutes such a burden on free expression, as to be unconstitutional under the Fifth and First Amendments; or at least raises such a serious question of constitutionality as to warrant rejecting it. This constitutional conflict is unnecessary since the correct interpretation of Sec. 16 accomplishes its purposes without discrimination or destruction of copyrights of American book authors. And, paradoxically, the correct interpretation does not thwart the purpose of Sec. 16—while the Copyright Office version does.

The Question

The question is whether Sec. 16 imposes on American authors an additional requirement for obtaining United States copyright in books and periodicals—namely that the first edition must be manufactured in this country.

Sec. 16 does not state any such condition. The Copyright Office reads it in by a process of constructions. Concededly, American manufacture is not required to obtain copyright in (i) music, plays or other classes of works by American or foreign authors, or (ii) in books in English by authors of most other countries, or (iii) books in other languages by foreign authors.

The Conflicting Interpretations of Sections 10 and 16

The Petitioner and the Copyright Office differ as to the correct interpretation of Sections 10 and 16 of the Copyright Act. Section 10 provides that any person

> "may secure copyright for his work by publication thereof with the notice of copyright required by this title. . . ."

This is the only requirement prescribed in the Act for obtaining copyright in a book or periodical. (Music, plays, and certain other works may be copyrighted by publication under Sec. 10: or by registration prior to publication, under Sec. 12.)

Petitioner contends: That publication of an American author's book with proper copyright notice secures for him (as it does for foreign authors) the United States copyright, regardless of where the first copies are manufactured or published. If the first copies are manufactured abroad, he may not import them (Secs. 16 and 107); and, he may not sue for infringements here until he deposits two copies of an American manufactured edition in the Copyright Office (Secs. 13, 16, and 17). If he wishes to sue for infringements before an edition is manufactured here [or import up to 1500 foreign copies], he may file for *ad interim* copyright (Sec. 22).

The Copyright Office contends: That in addition to complying with Sec. 10, an American author of books must also have the first edition manufactured here to obtain copyright in his book. If it is manufactured abroad, he can only obtain copyright by filing for *ad interim* copyright under Sec. 22 and then publishing an American manufactured edition within five years (Sec. 23).

POINT I

The Copyright Office Construction Would Render Section 16 Unconstitutional.

The Fifth Amendment

For the reasons indicated in Point II, we submit that the Copyright Office's construction of Section is erroneous. Moreover, if Sec. 16 is construed as the Copyright Office contends, it would be unconstitutional under the Fifth Amendment.

In *Schneider* v. *Rusk*, 377 U.S. 163, 168 (1963), the Court ruled:

> "Moreover, while the Fifth Amendment contains no equal protection clause, it does forbid discrimination that is 'so unjustifiable as to be violative of due process.' *Bolling* v. *Sharpe*, 374 U.S. 497, 499."

The statute held unconstitutional in *Schneider* discriminated between two classes of American citizens living abroad, favoring the native born over the naturalized. Under the Copyright Office interpretation, Sec. 16 discriminates against American authors of books that are manufactured abroad—denying them a fundamental right granted to: (i) foreign authors of books manufactured abroad and (ii) American or foreign authors of other classes of copyrightable works manufactured abroad. The discrimination is so unjustifiable as to violate the due process requirements of the Fifth Amendment.

(i) Foreign authors of books in other languages obtain full (28 years) copyright under Sec. 10 by publication with proper notice—the first edition may be manufactured and sold abroad, or here. Foreign authors of books in English

also obtain full copyright by publication with appropriate notice if they are citizens of countries adhering to the Universal Copyright Convention—the first edition may be manufactured and sold abroad, or here. (Most English speaking countries adhere to the Convention.)

Thus these foreign authors are not required to have the first (i.e. copyright-securing) edition manufactured in the United States; they are not required to file for *ad interim* copyright or secure an American made edition within 5 years of first publication; they are free to have all editions manufactured outside the United States; and they may import copies in unlimited quantities.

But American book authors, under the Copyright Office version of Sec. 16, are denied the same right to secure United States copyright by publication of a foreign manufactured edition. This discriminates against the American Author who may only be able to have a book published in another country, because he lives there or cannot find an American publisher willing to issue it. The *ad interim* clause does not eliminate this discriminatory treatment. It requires the author to obtain an American made edition within 5 years or lose all protection. The author may be unable to find an American publisher in time; and would then have to incur the additional expense of publishing an edition here himself or lose his copyright.

(ii) Under the Copyright Office construction, Sec. 16 also discriminates between American authors of books and authors (American and foreign) of all other classes of works. The American (or foreign) author of a musical composition, play, motion picture or any other work (except a book or periodical) obtains full copyright under Sec. 10 by pub-

lication of his work, with notice,—even though the first copies are manufactured or produced abroad. He need not comply with Sec. 22; he never need manufacture copies here; he can import foreign copies without limitation; and he can sue for infringements here, even though every copy sold in this country was manufactured abroad.

(iii) There is absolutely no justification for interpreting Sec. 16 to deny American book authors the right, granted other American and foreign authors, to secure copyright on publication of a foreign manufactured edition. As indicated in Petitioner's brief, the purpose of Sec. 16 was to give American printers and book manufacturers the opportunity to produce the copies to be sold in the American market. That purpose is secured by preventing the importation of foreign manufactured copies (Sec. 107); by requiring that American authors may not sue for infringement of copyright until an American edition has been manufactured; and by requiring that if such an author of a book copyrighted by publication abroad wished to sell copies in the American market, he must have these copies manufactured by an American printer.

On the other hand, the Copyright Office interpretation of Sec. 16—denying copyright to American books first manufactured abroad—defeats the very purpose of the Section. If an American author's book is thrown into the public domain, under the Copyright Office version, the exclusive right to produce it for the American market is lost to American printers and book manufacturers. Once in the public domain the book is no longer subject to the requirements of Sec. 16 and Sec. 107—and foreign made copies can be imported without any numerical limitations.

The lack of justification for the Copyright Office construction is further emphasized by the fact that while importation of foreign made books has ceased to be a threat, the foreign manufacture of motion pictures and other works by American authors has had an increasingly serious effect on domestic producers of these works. Yet the Congress has not imposed the requirement of American manufacture as a condition for obtaining copyright in these classes of works.

We submit that if Sec. 16 were construed to deny American authors of books the same right to secure copyright which is granted to foreign authors of books and to American and foreign authors of other works, the Section would violate the Fifth Amendment's prohibition against discrimination "so unjustifiable as to be violative of due process." (*Schneider* v. *Rusk, supra*, at p. 168).

At the very least, the Copyright Office construction would create such doubts as to the constitutionality of Sec. 16 as to render it inacceptable. As Justice Holmes said, in *United States* v. *Jin Fuey Moy*, 241 U.S. 394, 401:

> "A statute must be construed, if fairly possible, so as to avoid not only the conclusion that it is unconstitutional but also grave doubts upon that score. (*United States* v. *Delaware & Hudson Co.*, 213 U.S. 366, 408)"

In *Fed. Trade Comm.* v. *Amer. Tobacco Co.*, 264 U.S. 298, Mr. Justice Holmes said:

> "We cannot attribute to Congress an intent to defy the Fourth Amendment or even to come so near to doing so as to raise a serious question of constitutional law." (P. 307)

In *Crowell* v. *Benson*, 285 U.S. 22, 62, Chief Justice Hughes said:

> "When the validity of an act of the Congress is drawn in question, and even if a serious doubt of constitutionality is raised, it is a cardinal principle that this Court will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided."

See also:

> *United States* v. *Witkovich*, 353 U.S. 194, 201; *Ashwander* v. *Tennessee Valley Authority*, 297 U.S. 288, 348; *Panama R.R. Co.* v. *Johnson*, 264 U.S. 375, 390; *Missouri Pacific R.R. Co.* v. *Boone*, 270 U.S. 466, 471, 472; *Richmond Co.* v. *United States*, 275 U.S. 331, 346; *Blodgett* v. *Holden*, 275 U.S. 142, 148; *Lucas* v. *Alexander*, 279 U.S. 573, 577.

We respectfully submit that "a construction of the statute is fairly possible by which the (constitutional) question may be avoided"—namely, the construction urged by the Petitioner.

The Copyright Office Version Poses Other Constitutional Conflicts

However construed, Sec. 16 penalizes American authors of books, denying them rights (to import foreign copies and sue without obtaining an American edition) which are granted to other American and foreign authors. As a punitive section, it should be narrowly construed in favor of the American book author; it should not be broadly construed, as the Copyright Office does, also to deprive him of the fundamental right to secure copyright.

The Copyright Office version of Sec. 16 violates the spirit, if not the very letter, of the Constitutional provision (Art.

I, Sec. 8) that authors be secured "the *exclusive* right to their respective writings. . . ." (emphasis supplied).

Moreover the Copyright Office version will, in some instances, impose a serious restraint on freedom of speech and press. Books and articles by American authors are published abroad for various reasons. One is that an author sometimes cannot find an American publisher willing to issue his book*. It is not uncommon that a work expressing politically or artistically controversial opinions sometimes must be first published in another country. The denial of American copyright under the Copyright Office version of Sec. 16 can restrain that publication. Faced with the loss of American copyright in his book, the American author may be forced to withhold it from publication anywhere until he can find an American publisher (which may mean a delay of years). Application for *ad interim* copyright involves the same threat, since the failure to publish an American edition within five years forfeits copyright.

This restraint on publication, by threat to copyright, does not arise under the construction of Sec. 16 urged by the Petitioner. Moreover this construction accomplishes the purpose of the section more effectively than does the Copyright Office version. We submit that the principle restated in *Louisiana* v. *N.A.A.C.P.*, 366 U.S. 293, warrants rejection of the Copyright Office construction. There the Court said:

> "We are in an area where, as *Shelton* v. *Tucker*, 364 U. S. 479, emphasized, any regulation must be highly selective in order to survive challenge under the First Amendment. As we there stated: '. . . even

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* This problem is compounded by the continuing reduction in the number and independence of American book publishers as the result of mergers and acquisitions of publishing firms by large conglomerate corporations which are scarcely interested in publishing controversial books.

though the governmental purpose be legitimate and substantial, that purpose cannot be pursued by means that broadly stifle fundamental personal liberties when the end can be more narrowly achieved.' ''

POINT II

Section 16 does not require that the first edition of Petitioner's novel be manufactured in this country in order that he secure copyright under Section 10.

Plaintiff's novel ''Candy'' was first published in France with the proper notice of copyright. According to the provisions of Section 10, this automatically secured United States copyright in the work. Section 16 does not require, as a condition for securing copyright, that the first edition be manufactured in the United States. However, the Copyright Office, erroneously contending that American manufacture is a condition for securing copyright under the Act, denied registration under Sections 13 and 17.

We submit that the Copyright Office's interpretation of the Act is erroneous for these reasons.

(i) *Sec. 10.* The Section specifies the method by which an author may obtain copyright in his ''work''—i.e., ''by publication thereof with the notice of copyright required by this title. . . .'' This is the sole requirement imposed by the Section.

Section 10 does not require that the first edition, by which copyright is secured, be manufactured in this country. Concededly, the publication of an American author's musical composition or play in a foreign country with

proper notice of copyright—in a foreign made edition—automatically secures United States copyright under Sec. 10. The Section makes no distinction between classes of authors or classes of works. It applies to all copyrighted works by all authors. It does not exclude books, or American authors.

Sec. 10 does not say that its requirement is subject to additional conditions set forth in either Sec. 16 or Sec. 22. And, neither Sec. 16 or Sec. 22 state that, in addition to the requirement of Sec. 10, the American manufacture of the first edition is a condition for obtaining copyright in an American book. Yet, if such a condition were intended by Congress, it was important enough (and easy enough) to be stated explicitly.

(ii) *Sec. 16.* The operative language of the section states that "all copies accorded protection under this title . ... shall be" printed and bound in the United States. The Copyright Office claims this requires, as a condition for securing copyright, that the first edition of an American author's book must be manufactured here.

The Copyright Office is wrong. The Section does not state any requirement for "secur[ing] copyright"; and the operative language of the Section does not use the word "copyright" at all. On the contrary it speaks of "the text of all copies accorded protection." Unlike Sec. 10, Sec. 16 does not deal with the process of securing copyright. Rather, like Sec. 13 it is a provision dealing with remedies, and the right to enforce a copyright already secured under Sec. 10. Sec. 13 requires the deposit of copies and registration as a condition for suing to protect the copyright "secured by publication of the work with the notice of copyright as provided in sec-

tion 10 . . .'' These events may occur years after the work is copyrighted by publication. *Washingtonian Pub. Co., Inc.* v. *Pearson*, 306 U.S. 30.

Moreover, a condition for securing copyright, read in by the Copyright Office, cannot be fairly or logically construed from the language of Sec. 16 (read alone or in conjunction with Sec. 22.)

For one thing, the operative language of Sec. 16 cannot be read as a condition applying solely to the copies constituting the first edition of a work. It makes no distinction between copies of the first edition, and the copies of subsequent editions—it applies to all copies. If an American author's book were first published here, in an American-manufactured edition, it would (according to the Copyright Office interpretation) have secured copyright. But if subsequent editions of the book were manufactured abroad, the operative language of Sec. 16 would apply to these copies with the same effect as it would have if the first edition were manufactured abroad. If Sec. 16 were construed as a requirement that, to secure copyright, the *first* edition must be manufactured here, it would logically follow that once that condition were complied with, *subsequent* editions could be manufactured abroad and imported. Sec. 107 would not prevent importation since it bars only the importation of copies not manufactured in accordance with Sec. 16, and according to the Copyright Office Sec. 16 would not apply to such subsequent editions. Yet this would defeat the purpose of the clause, which is to preserve for American printers the opportunity to manufacture those copies of an American author's book which are sold in this country.

Clearly, then, the language of Sec. 16 cannot be interpreted as a condition for securing copyright because the

same language applies to later foreign editions of books which were *first published* in American-manufactured first editions—and had already secured copyright. It is impossible to distill from the turgid language of Sec. 16 *two* different sets of conditions, one applying to the first edition, the other to subsequent editions—yet that is what the Copyright Office is attempting to do.

We believe that the only construction of Sec. 16, permitted by its language and logic, is that (i) it requires that the copies of an American author's book which are sold in the United States must be manufactured here (except for the 1500 copies he may import, if he elects to obtain *ad interim* copyright under Sec. 22); and (ii) that if the first edition, by which the author obtained copyright under Sec. 10, is published abroad he may not sue for infringement of copyright in this country until he has obtained an American manufactured edition and deposited 2 copies in the Copyright Office, pursuant to sec 13. (One reason for choosing to obtain *ad interim* copyright is that it permits the author to sue for infringement during the 5-year period even though an American manufactured edition has not been published.)

(iii) *Sec. 22.* The Copyright Office relies on its interpretation of Sec. 16 to deny registration to plaintiff. It does not contend that appellant's failure to comply with Sec. 22, deprived him of his copyright—but rather that since he did not choose this alternative means, he lost his copyright under its interpretation of Sec. 16.

We agree with the petitioner that Sec. 22 is a permissive section. It permits the author of a book first published abroad to import 1500 copies despite the restriction of the Manufacturing Clause; and, as we have noted, where the first edition is manufactured abroad, it offers a means of

avoiding the requirement of depositing American made copies (under Sec. 13) as a condition of suing for infringements occurring during the *ad interim* period. But it is clear from the language of Sec. 22 that it is not a mandatory requirement for procuring copyright in a book first published abroad by an American author. Its language in no way provides, or suggests, that it is a compulsory alternative to securing copyright under Sec. 10.

Moreover, the Copyright Office has conceded that where the first edition of a work published abroad is manufactured in the United States, Sec. 22 does not apply—and the author obtains copyright under Sec. 10. This concession necessarily proceeds from the premise that Sec. 22 is permissive. There is no provision for such an exception in the Section. It does not speak of the place of manufacture. It only deals with books "first published abroad." Consequently, if it were mandatory, then a book in English first published abroad would have to be registered for *ad interim* copyright even though the edition had been manufactured in the United States.

In addition, Congress has made it clear that Sec. 22 is permissive. In 1954, it amended Sec. 9 of the Act to exempt foreign authors (from countries adhering to the Universal Copyright Convention) from certain sections of the Act, including Sec. 16. However, no exemption was granted from Sec. 22 or Sec. 23. This establishes that Congress construed Sec. 22 as being entirely permissive. If it were mandatory, foreign authors would still be required to file *ad interim* copyright for books in English when published broad—because the section does not deal with place of manufacture but with place of publication. However, the Copyright Office concedes that such authors are not required to comply with Sec. 22 because they are not affected by Sec. 16.

CONCLUSION

It is respectfully submitted that a Writ of Certiorari should be granted and the decision of the Court of Appeals should be reversed.

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No. 315

In the Supreme Court of the United States

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MASON HOFFENBERG, PETITIONER

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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OPINION BELOW

The district court wrote no opinion. The *per curiam* opinion of the court of appeals has not yet been officially reported, but appears at 157 U.S.P.Q. 358.

JURISDICTION

The judgment of the court of appeals was entered on April 23, 1968. The petition for a writ of certiorari was filed on July 19, 1968. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether Sections 22 and 23 of the Copyright Act (17 U.S.C. 22, 23) provide the exclusive method for securing copyright on an English-language book written by an American author which is first manufactured and published abroad.

STATUTES AND REGULATION INVOLVED

The relevant portions of the Copyright Act (17 U.S.C. 1 *et seq.*) and the pertinent regulation are set out in Appendix A to the petition (pp. A–1 to A–5).

STATEMENT

Petitioner is an American citizen and a co-author of the novel "Candy". The first edition of this novel, which was written in English, was manufactured and published in Paris in 1958. Each copy of this Paris edition included the notice of copyright described by 17 U.S.C. 19, 20. No further steps were taken at that time to obtain copyright protection under the Act.

In 1964, G. P. Putnam's Sons published an American-manufactured edition of "Candy" in the United States. In March 1965, more than six years after the first publication of the Paris edition, petitioner submitted to the Copyright Office an application which sought to register the American edition of "Candy" for copyright.

By letter of March 31, 1965, the Copyright Office refused to register the work for copyright. It gave as the ground for this refusal petitioner's failure to comply with its pertinent regulation—37 C.F.R. 202.4

(b)(1) (Pet. App. A–5)—which, the Office stated, implements the statutory scheme of the Act. That regulation provides in part: "An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered [for copyright] unless an ad interim registration is first made." Specifically, the Office noted that since "Candy" had been first manufactured and published abroad (and thus did not meet the requirement of 17 U.S.C. 16 that "all copies [to be] accorded protection under" the Act be manufactured in the United States), it could not be registered for copyright in the United States unless petitioner had satisfied the Act's special provisions (17 U.S.C. 22, 23) governing protection of an American copyright during the interim between publication of a foreign-manufactured, English-language work and the later publication of an American-manufactured edition. Since the ad interim provisions had not been complied with (in that petitioner had failed to deposit a copy of the Paris edition with the Register of Copyrights within six months of its publication, as required by 17 U.S.C. 22), the Office refused to register the American edition for copyright.

Thereupon, on May 3, 1965, petitioner filed the complaint in the present action, challenging 37 C.F.R. 202.4(b)(1) as inconsistent with the Act and the Constitution, and seeking to require the Register of Copyrights to register the work for copyright. The

district court, on cross-motions for summary judgment, granted the Register's motion and dismissed the cause.

The court of appeals affirmed the dismissal in a *per curiam* opinion. It held that the regulation in question "is not only not inconsistent with the pertinent sections of the Copyright Code, but in our judgment it accurately reflects the intention of Congress. * * * Even if there were some doubt, we would be required to resolve that doubt in favor of the Register's interpretation. *Udall* v. *Tallman*, 380 U.S. 1, 16 (1965)" (Pet. App. A–8).

ARGUMENT

The decision below correctly interprets the Copyright Act and the pertinent regulation,[1] in the light of the statutory purpose and legislative history, and this interpretation is free of any constitutional infirmity. Moreover, the question presented by this case is not of recurring importance, and, indeed, the rele-

[1] 17 U.S.C. 207 plainly authorizes the Register of Copyrights "to make such rules and regulations for the registration of claims to copyright as provided by this title." 37 C.F.R. 202.4(b)(1) is such a regulation. Nonetheless, petitioner contends that the Copyright Office's view of the statute, as embodied in this regulation, is entitled to no weight, and appears to question the Office's authority to adopt regulations relating to the circumstances under which copyrights are secured (Pet. 24–25). It seems clear, however, that Congress did not intend the Office's authority to be that narrowly circumscribed. See *Bouvé* v. *Twentieth-Century Fox Film Corp.*, 122 F. 2d 51, 53–54 (C.A.D.C.).

vant statutory provisions will likely be materially amended by Congress in the near future. Thus, there is no need for further review.

1. 17 U.S.C. 10 provides the basic method by which books are copyrighted in the United States. It states in part that "[a]ny person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title * * *."[2] Section 10 is modified by 17 U.S.C. 16, which provides that "the text of all copies [of a book written in English] accorded protection under this title" must be manufactured in the United States. This language requires, in plain terms, that to be accorded copyright protection as a result of publication with notice under Section 10, a book must meet the domestic-manufacture requirement of Section 16. An exception to this requirement is provided by the "ad interim" provisions, 17 U.S.C. 22, 23.[3] Those sections permit, under specified and limited conditions, a book written in English but manufactured and published abroad, to receive interim copyright protection under the Act (for up to five years) until an American-made edition can be published. Section 22 provides:

> In the case of a book or periodical first published abroad in the English language, the de-

[2] The requirements for the form and content of such notices are set out in 17 U.S.C. 19, 20.

[3] Under certain conditions, 17 U.S.C. 9(c) completely exempts foreign works entitled to protection under the Universal Copyright Convention from the manufacturing requirement of Section 16. The exemption is not applicable to works by American authors.

> posit in the Copyright Office, not later than six months after its publication abroad, of one complete copy of the foreign edition, with a request for the reservation of the copyright and a statement of the name and nationality of the author and of the copyright proprietor and of the date of publication of the said book or periodical, shall secure to the author or proprietor an ad interim copyright therein, which shall have all the force and effect given to copyright by this title, and shall endure until the expiration of five years after the date of first publication abroad.

Section 23 provides that if an American edition of a work which has obtained ad interim protection is published in the United States within the period of ad interim protection, and the American edition satisfies the domestic-manufacture requirement of Section 16 and meets the other usual requirements for the obtaining of a copyright, then the ad interim copyright shall be extended to the full term provided by the Act.[4]

Here petitioner concededly failed to meet the requirements for ad interim copyright for "Candy", and the court of appeals, agreeing with respondent, found that "Candy" was therefore not copyrightable. This was so, the court concluded, because the ad interim provisions afford the only method by which an American author can obtain a copyright on a book written in English but first published abroad in a foreign-manufactured edition.

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[4] The full term, pursuant to 17 U.S.C. 24, is 28 years, renewable for an additional 28 years.

Petitioner contended below, however, and renews his contention here, that the ad interim provisions are merely an alternative method for obtaining a copyright for a book such as "Candy", and that first publication of "Candy" with notice of copyright pursuant to Section 10, even though the work was published abroad in a foreign-manufactured edition not satisfying Section 16, was itself sufficient to accord the work full copyright protection (not merely the interim protection of Sections 22 and 23).

This contention is erroneous, in that it both ignores the clear effect which Section 16 has upon Section 10, and leaves the ad interim provisions without any impact at all, transforming them into useless surplusage, a result Congress could hardly have intended. Petitioner ignores the language of Section 16 in maintaining that the Section 10 requirements for obtaining a copyright on a book may be fulfilled by publication with notice anywhere, for Section 16 plainly states that "the text of all copies accorded protection under this title" must be manufactured within the United States. Obviously, the securing of a copyright brought about by publication with notice under Section 10 affords such "protection". Since Section 16 requires that books to be afforded protection be manufactured domestically, it follows that compliance with Section 10 is insufficient to obtain a copyright for a book unless the publication with notice required by that section is carried out in an edition which meets the domestic-manufacture requirement of Section 16.

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Petitioner seeks to escape the plain meaning of this statutory language by a discussion of the evolution of the manufacturing provision into its present form. Petitioner correctly points out that before the enactment of the present Act in 1909, the obtaining of a copyright on a book was conditioned on deposit of two copies of the first edition of the book with the Copyright Office on or before the date of first publication, and that those deposited copies were required to have been manufactured in the United States (26 Stat. 1107). Thus, before the 1909 Act, a copyright could only be obtained if the first edition of the book was domestically manufactured. Petitioner then argues that because the 1909 Act abandoned this method of securing a copyright in favor of the present method of publication with notice as required by Section 10, Congress must no longer have been interested in requiring that the first edition of a work to be copyrighted be manufactured and published in the United States. He concludes that it is sufficient to satisfy Section 10—and a copyright is thereby obtained—if publication with notice occurs anywhere in the world.

However, petitioner has cited no authority to indicate that this 1909 change in the method of securing a copyright was intended by Congress to effect such a dramatic curtailment of the domestic-manufacture requirement. Indeed, the legislative history shows that in dropping the requirement of registration of two copies as a precondition to obtaining a copyright, Congress had nothing more in mind than the soften-

ing of the harsh effect of that portion of the prior law which had conditioned copyright on timely deposit of copies. As stated in H. Rep. No. 2222, 60th Cong., 2d Sess., p. 11: "The failure of a shipping clerk to see that the copies go promptly forward to Washington may destroy a copyright of great value, and many copyrights have been lost because by some accident or mistake this requirement was not complied with. The committee felt that some modification of this drastic provision, under which the delay of a single day might destroy a copyright, might well be made." See *Washingtonian Co.* v. *Pearson,* 306 U.S. 30, 39–42.[5] Nothing in this report, nor in any other history surrounding the Act, indicates that this change in the method of securing a copyright had anything to do with a shift in Congress' attitude toward the purposes to be served by the manufacturing clause.

Thus, petitioner has given no reason for ignoring the plain requirement of Section 16 that, to be accorded copyright protection under Section 10, a book must be manufactured within the United States.[6]

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[5] We recognize that the Court in *Washingtonian*, on which petitioner extensively relies (*e.g.*, Pet. 22), concluded that, under the 1909 Act, it is unnecessary "to deposit anything to secure a copyright of a published work, but only to publish with the notice of copyright" (306 U.S. at 37). But there the book was manufactured and first published in this country. Thus, only Section 10 was involved, and there was no occasion to consider the domestic-manufacture requirement of Section 16 which is involved here. Indeed, the only issue in *Washingtonian* concerned the time within which a work published here could be deposited for registration under Section 13 of the Act.

[6] Petitioner argues at length that Section 16 cannot in all situations be taken literally to mean what it says, for, he states, a literal reading would lead to the conclusion that a work first

2. Another consideration calling for rejection of petitioner's contention is that his reading of the Act in effect leaves Sections 22 and 23 with no meaning. Under the Copyright Office's interpretation, as upheld by the court of appeals, the ad interim provisions are the sole exception to Section 16 in permitting copyright protection for English-language works by American authors first published in an edition not meeting the domestic-manufacture requirement. According to petitioner, however, the explicit requirements for obtaining ad interim protection may be avoided by publishing a foreign-manufactured work abroad with the notice of copyright as required by Section 10. This latter method, which petitioner argues that Congress intended as an alternative to the ad interim provisions, is not only cheaper and less demanding than the ad interim procedure, but would

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published in the United States with copyright notice in an edition meeting the Section 16 requirements (thus being copyrighted under Section 10) would perforce lose such protection if a subsequent edition of the work were manufactured and published abroad (Pet. 13–15). According to petitioner, since such a result would be absurd, Section 16 may not be read literally even in the instant case. Even assuming that petitioner is correct about his hypothetical case, it has no pertinence here. This case is concerned with the requirements of the Act for obtaining a copyright and not with the possibility of losing one once it has properly been obtained. Moreover, the fact that the language of Section 16 may be susceptible of producing an anomalous result in one situation is no reason to ignore the plain meaning of that language where it would, as in the instant case, produce a result which is consistent with the effect of previous statutes, especially where, as here, Congress has not stated that it intended the 1909 Act to alter that result.

result in protection for the full 28-year copyright term, while the ad interim provisions allow only a maximum of five years' protection before a domestically manufactured edition must be printed to qualify for full-term protection.

Petitioner does not suggest, nor can we imagine, why Congress placed Sections 22 and 23 in the Act at all if their strictures may so easily and so profitably be avoided. Rather than explain why the ad interim provisions do not become mere surplusage under his reading of the Act, petitioner makes the flat assertion that the use of the ad interim procedure has "certain advantages and disadvantages" (Pet. 13), without showing what advantages there are which might lead an author to seek ad interim copyright rather than Section 10 copyright. Absent such a showing, petitioner's interpretation deprives the ad interim provisions of any meaningful effect, and fails to satisfy the most familiar canon of statutory construction—that a statute must be construed to give meaning to all of its parts. Thus, Sections 22 and 23 of the Act cannot sensibly be viewed as anything other than the sole method for securing a copyright for an English-language book by an American author first published abroad in a foreign-manufactured edition.

3. Congress not only gave no indication at the time it passed the 1909 Act that it was providing an alternative to the ad interim provisions, but it has twice amended the ad interim provisions, each time on the explicit assumption that Sections 22 and 23 do prescribe the sole method for obtaining a copyright

in an English-language work by an American author whose first publication was in a foreign-manufactured edition.

The first such amendment was in 1919 (41 Stat. 368). This amendment liberalized the ad interim provisions by extending from 30 to 60 days the period after foreign publication during which a copy of the work for which ad interim protection is sought must be sent to the Copyright Office, and by extending the term of ad interim protection from 30 days to four months.[7]

In so making ad interim copyright easier to obtain and more valuable, however, Congress made it clear that it regarded the ad interim provisions as the only way to secure American copyright in a foreign-manufactured, English-language work. The report of the Senate Committee on Patents (adopting the statement of the Register of Copyrights) said in part (S. Rep. No. 326, 66th Cong., 2d Sess., p. 3):

> The purpose of [the changes in the ad interim provisions] * * * is to facilitate compliance with the requirement of our law that a foreign book in the English language must be type set, printed, bound, and republished in the United States in order to secure copyright protection. The bill does not propose any change whatever in the so-called manufacturing requirements of our copyright laws.

[7] In addition, the amendment allowed all foreign-manufactured, English-language works which had been produced or published during the First World War a grace period within which the ad interim registration provisions could be satisfied.

Congress again amended the ad interim provisions in 1949 (63 Stat. 153). This amendment further increased the period following foreign publication during which a copy must be sent to the Copyright Office—from 60 days to six months—and increased the term of ad interim copyright protection from four months to five years.[8] This major revision of these provisions was accompanied, as the 1919 amendments had been, by a clear statement by Congress that it was basing the amendment on the assumption that the ad interim provisions were the exclusive method for obtaining a copyright in an English-language book first manufactured and published abroad. For instance, the report of the Senate Judiciary Committee, in explaining the scope of the amendment, stated in part (S. Rep. No. 375, 81st Cong., 1st Sess., p. 1):

> The present United States law requires all foreign authors and publishers of books and periodicals written in the English language to do two things to obtain copyright in the United States: They must (*a*) register the book or periodical within 60 days of publication abroad and (*b*) manufacture the work within 4 months thereafter. The bill allows 6 months for registration in the United States Copyright Office and 5 years within which to manufacture in the United States. * * *

[8] The 1949 amendment also permitted importation into the United States of 1500 copies of the foreign edition of certain works in order to allow the author to test the American market for his work (see S. Rep. No. 375, 81st Cong., 1st Sess.).

Moreover, the legislative history demonstrates that the 1949 amendment was more than a further liberalization of the ad interim provisions; it was a balance struck by a Congress which had considered the conflicting interests of various groups in the continued vitality of the manufacturing provisions in the light of changing conditions.[9] The Senate committee noted that in 1948 "* * * over 14,000 books * * * [had been] published in England and yet only 139 books written in the English language in England and in all other foreign countries were registered in the United States Copyright Office" (S. Rep. No. 375, *supra*, p. 2). The House Judiciary Committee noted that the State Department had expressed the view "* * * that there were grave threats of retaliation by England and other foreign countries against the United States because of the existence of the requirement, in

[9] The House report states in part: "[F]or the purpose of indicating the wide support enjoyed by the bill in the publishing industry, organized labor, and in copyright-law circles, it is noted that its theory has been endorsed by the following groups and individuals, although some qualified their endorsement by suggested changes, some of which have been made by committee amendments: International Allied Printing Trade Council (AFL); American Book Publishers' Council, Inc., which includes the publishers of approximately 85 percent of all the trade books published in the United States today; the Register of Copyrights; the Authors' League of America; American Society of Composers, Authors, and Publishers; American Textbook Institute; Association of the Bar of the City of New York; and the National Association of Magazine Publishers. The committee was advised that this is the first time in 40 years that all parties interested in the subject have been able to reach an agreement on the general theory of the bill" (H. Rep. No. 238, 81st Cong., 1st Sess., p. 6).

order to secure United States copyright, that a work first published abroad in the English language be published in the United States" (H. Rep. No. 238, 81st Cong., 1st Sess., p. 3). Indeed, the State Department recommended that the domestic-manufacture requirement be eliminated entirely.[10]

However, the response of Congress was to reject this suggestion and leave the manufacturing requirement of Section 16 untouched,[11] but to liberalize substantially the ad interim provisions. In reaching this accommodation of the interests favoring retention of the manufacturing provisions with those favoring their abolition, Congress clearly relied on its assumption that Section 16 and the ad interim provisions mean that an American copyright could not be secured for a foreign-manufactured, English-language work unless the ad interim provisions were complied with.

The above-described congressional interpretation of the statutory scheme is more than probative evidence

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[10] See letter to the Senate committee, appended to S. Rep. No. 375, *supra*, pp. 5–7.

[11] Except for the amendment permitting import of 1500 copies of certain works protected by ad interim copyright (see note 8, *supra*).

of the meaning of the 1909 Act; it is "part of the arch on which the new structure" of the 1949 amendments rests, which this Court should refrain from disturbing "lest * * * [it] change the design that Congress fashioned." *State Board of Insurance* v. *Todd Shipyards,* 370 U.S. 451, 458. See *Mastro Plastics Corp.* v. *National Labor Relations Board,* 350 U.S. 270, 288–289.

Petitioner argues, however, that this subsequent history is unpersuasive because it is "nothing more than what individual Congressmen think" and because the amendments do not bear upon the present case (Pet. 22–24). These arguments are less than persuasive, for, as we have shown, the interpretation of the 1909 Act was stated by Congress in the reports of the committees charged with handling the legislation. Furthermore, the interpretation of the manufacturing and ad interim provisions was expressly considered by Congress in assessing the need for amendatory legislation and, perhaps more importantly, in tailoring the amendments to obtain specific results.[12] Thus, even if there were doubt as to the intention of Congress in passing the 1909 Act, that doubt was resolved

[12] Compare *United States* v. *Wise,* 370 U.S. 405, 411, upon which petitioner places primary reliance (Pet. 23–24). There this Court said: "The interpretation placed upon an existing statute by a subsequent group of Congressmen who are promoting legislation and who are unsuccessful has no persuasive significance here." In contrast, the situation here involves the opinions expressed in the committee reports accompanying successful amendment of the statute; as we have shown, these opinions serve as the foundation upon which the amendments rest.

in favor of the Copyright Office's position by later Congresses.[13]

4. Petitioner and the Authors League of America, Inc., as *amicus curiae,* also urge that the Act, as interpreted by the court of appeals, produces discriminatory treatment between American and foreign authors, and between American authors who publish domestically and those who publish abroad. It is contended that such discrimination violates the due process clause of the Fifth Amendment to the Constitution.

Congress, under its exclusive power to "* * * [secure] for limited Times to Authors * * * the exclusive Right to their respective Writings * * *" (U.S. Const., Art. I, Sec. 8), has chosen to make copyrights available only on condition that books be manufactured in the United States. Section 16 of the

[13] Petitioner alternatively argues that, even if his view of Sections 10 and 16 is rejected, so that he is not regarded as having secured a copyright by publication abroad in 1958, he nonetheless should be held to have secured a copyright on "Candy" by publication in this country in 1964 (Pet. 15, 24). In this regard petitioner places reliance on *United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260. That case, however, is inapposite, for there an American copyright had been obtained, and the precise question was whether notice thereof in books published abroad and sold only for use there was required to protect the American copyright (see 208 U.S. at 266). No such issue is raised here, for petitioner took no steps, beyond publishing abroad with notice, to obtain an American copyright in 1958. Nor is *Heim* v. *Universal Pictures Co.*, 154 F. 2d 480 (C.A. 2) in point. That case involved a musical composition first published abroad by a foreign author, so that Section 16 had no application. Moreover, petitioner's contention in this respect, like his principal argument, would render Sections 22 and 23 nugatory.

Act, by protecting domestic publishers and manufacturers from foreign competition, serves to ensure the continued health of the American publishing industry as a market for American authors. Consequently, the distinction drawn by Congress between the requirements for copyright of books manufactured domestically and those manufactured abroad is one reasonably related to Congress' constitutional authority.[14]

Petitioner and the *amicus* argue, however, that the purposes of the domestic-manufacture requirement are not relevant when, as in the instant case, the author did not initially seek an American market for his work. They claim that when an author seeks only a foreign market, his resort to a foreign-manufactured edition does not impose a threat to American publishers. Petitioner and the *amicus* fail to note, however, that in requiring American authors writing for foreign markets to manufacture their books within the United States (or, under the ad interim provisions, to manu-

[14] In enacting copyright legislation Congress can "attach what conditions it [sees] fit to its grant" (*United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260, 264). Moreover, Congress has the authority, under its power "[t]o regulate Commerce with foreign Nations" (U.S. Const., Art. I, Sec. 8), to enact measures designed to protect and foster American business interests, and the instant legislation may be sustained on that ground as well. See *Legal Tender Cases*, 12 Wall. 457, 534. Indeed, petitioner makes explicit reference to "the protectionist purpose of the manufacturing clause" (Pet. 14). His suggestion that "American printers do not gain but rather stand to lose" by the Office's view of the statutory provisions here involved (Pet. 20) seems premised on the assumption—quite incorrect, we submit—that most American authors first publishing abroad would fail, as did petitioner, to comply with the ad interim provisions (see Pet. 26).

facture a domestic edition within five years of the first foreign publication), Section 16 does satisfy the congressional design of supporting domestic printers and publishers at the expense of their foreign counterparts.[15]

Petitioner and the *amicus* further argue that the congressional implementation of the Universal Copyright Convention [16] relieves most foreign authors of the necessity of complying with Sections 22 and 23, thereby discriminating against American authors writing for foreign markets by leaving them as the only group which must comply with those provisions. However, the distinction drawn between American and foreign authors in this connection is a valid one, for the benefits given by the treaty to writers of foreign countries have been given in return for the grant by those countries to American authors of the protection of their copyright laws. See 17 U.S.C. 9(b). This *quid pro quo* is sufficient justification, if one is needed, for treating foreign authors differently from American authors.[17]

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[15] The *amicus* notes that plays and musical compositions are treated differently under the Act than books. However, Congress could properly determine that the domestic-manufacture requirement was necessary for books, but not other works. In point of fact, that requirement did at one time apply to such works, but was later changed so as not to include them.

[16] The provisions of that treaty are reprinted following 17 U.S.C. 9.

[17] Petitioner and the *amicus* also suggest that the Office's interpretation of the Act results in an impairment of free expression inconsistent with the First Amendment (*e.g.*, Pet. 27). What form this alleged impairment takes is not, however, spelled out. Nothing in the Office's view of the pertinent statutory provisions chills an author's incentive to write, or is

5. Whatever general importance the question presented in the instant case might otherwise have [18] is significantly diminished by the fact that Congress is at present actively considering the problem involved. H.R. 2512, 90th Cong., 1st Sess., which passed the House of Representatives on April 11, 1967 (113 Cong. Rec. (daily ed.) H3888), and is currently before the Senate, would amend Title 17 of the United States Code in its entirety. Section 601 of this proposed revision substantially alters the manufacturing provisions of the present Act and removes the ad interim provisions with which this case is concerned. The House Judiciary Committee, in favorably reporting the bill, stated: "Subsection (d) of section 601 makes clear that compliance with the manufacturing requirements no longer constitutes a condition of copyright protection, and that the effects of noncompliance are limited to rights with respect to reproduction and distribution of copies. The bill does away with the special 'ad interim' time limits and registration requirements of the present law * * *" (H. Rep. No. 83, 90th Cong., 1st Sess., p. 137). In view of the likelihood that the question presented by this case will shortly be answered by Congress itself, it is not one of recurring importance and the decision below is unlikely to be of continuing significance.

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calculated to undermine his expected rewards from the publication of his works. All that the Act requires is that, where an American author desires to publish a book abroad in the first instance, he follow certain prescribed steps to obtain copyright protection therefor in this country.

[18] So far as we can determine, this is the only case which has ever raised the question presented. Indeed, petitioner refers to the issue as one "almost totally unexplored by the courts" (Pet. 5).

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

MASON HOFFENBERG,

Petitioner,

—v.—

ABRAHAM L. KAMINSTEIN, Register of Copyrights.

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY BRIEF

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IN THE

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October Term, 1968

No. 315

MASON HOFFENBERG,

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(1)

Respondent attempts to deprecate the importance of the issue (a) by saying that it has not previously been adjudicated (Resp. 20, fn. 18) and (b) by saying that the pertinent statutory provisions are "likely" to be amended by Congress "in the near future" (Resp. 5, 20).

Respondent offers nothing in support of the assertion that amendment is likely or of the guess as to when it might occur. The attempt to effect a revision of the Copyright Act has been going on—without success—for the past decade, and such indications as there may be of future Congressional action contradict the respondent's estimate. (We respectfully refer the Court to the newspaper report cited Pet. 8, first fn. and 9). But, in any case, the present question is not answered by the possibility of future events. The proposed amendments to which respondent refers apply only

prospectively. There are sixty years of writing that will continue to be governed by the current provisions even if these proposals were to become law tomorrow. The importance of the question has been enhanced in recent years, during which the paperback revolution and other developments have increased the number of works now published here that were first published abroad. The rights that hinge on the outcome of the present case (Pet. 6-8) are not affected by such changes in the law as the respondent (quite unrealistically, we suggest) asks the Court to assume are "likely" and "near".

As to the fact that the issue has not been adjudicated, this Court, in one of the relatively few cases in which it has construed the Copyright Act, has made it clear that the absence of prior decision is not a reason for denying certiorari. In *De Sylva* v. *Ballentine*, 351 U.S. 570 (cert. granted 350 U.S. 931), the opinion stated at the outset:

> "* * * Strangely enough, these questions have never before been decided, although the statutory provisions involved have been part of the Act in their present form since 1870." (351 U.S. 570, 572-3.)

Another aspect of the *De Sylva* opinion is apposite here. Petitioner and several *amici* had argued that the interpretation they were urging was "universal." The Court described this as an "overstatement", and ruled the other way, observing that the Copyright Office "recognized [the section's] ambiguity" and that "more than one qualified commentator" had either expressed doubt on the question or come to a different conclusion (351 U.S. 570, 578). The parallel to the present case is striking. Here the Copyright Office has recognized ambiguity by shifting its position; it espoused one interpretation of the statute until

1956 and another, contrary, interpretation after that date (Pet. 25). And the three foremost commentators in the field have all treated the present question as an open one. See Chafee, *Reflections on the Law of Copyright,* 45 Col L. Rev. 503, 528 (1945); Howell, *The Copyright Law* (Third edition 1952) pp. 93-100; *Nimmer on Copyright,* § 96.4, p. 363.2.

(2)

Respondent, conceding that §10 "provides the basic method by which books are copyrighted," goes on to say that §10 "is modified" by §16 (Resp. 5). This, of course, is a conclusion. Section 16 makes no reference to §10. Neither do §§ 22 or 23. Nor does the explicit language of § 10 in any way indicate that its copyright-securing process is limited by any other section of the Act. Copyright is obtained by complying with the first clause of § 10 (as petitioner has done here), unless, wishing to take advantage of the provisions of § 22 in the circumstances it describes, an author chooses to employ this special procedure in place of the "basic method." An ordinary reading of the statute gives the impression (confirmed by legislative history) that the right is established by the first clause of § 10. Other parts of the Act affect the enforcement and continued existence of the right.* Remedies depend on compliance with § 13, and forfeiture of the right will follow from violation of § 16, or from violation of the second clause of § 10 itself. Only in this sense may it fairly be said that § 16 modifies § 10.

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* See S. Rep. No. 6187, 59th Cong. 2d Sess. (1907) pp. 4-5, which includes the following:

> ". . . The protection is to be initiated by this act [of publication with notice] alone, and will not be lost by later omissions, though these may fatally impair the remedy against a particular infringer."

See also H. Rep. No. 7083, 59th Cong. 2d Sess. (1907) p. 8; S. Rep. No. 1108, 60th Cong. 2d Sess. (1909) p. 10.

Petitioner contends—and the contention is supported by the history and purposes of the manufacturing clause, and by the general principle that a statute is not given extra-territorial effect unless the intent to do so is clear—that § 16 applies to the manufacture of books offered for sale in the American market, and not to books offered for sale in foreign markets. Respondent argues that this is "a dramatic curtailment of the domestic-manufacture requirement" (Resp. 8). But this is exactly the scope of the requirement that Congress had in mind (Pet. 18-20). And in fact the Copyright Office interpretation involves a more drastic curtailment, and one inconsistent with Congressional purposes, since its effect is to increase the opportunities for importation of books printed abroad (Pet. 26-27).

No edition after the first edition, says the Copyright Office, need comply with the requirements of § 16. When the brief for respondent states that ". . . Section 16 requires that books to be afforded protection be manufactured domestically . . ." (Resp. 7), it makes a statement inconsistent with the position taken by respondent in the courts below. Petitioner has pointed out that all important American literary works of this century have had subsequent editions published in Great Britain and manufactured there. Respondent has up to now agreed (and we do not read his brief as abandoning this position, despite the quoted statement) that these works must be, and are, "afforded protection" even though they are not "manufactured domestically."* Respondent is unwilling to say that these works are in the public domain, and in this respondent is correct. They are

* Thus, for example, respondent's brief in the Court of Appeals (at p. 43): ". . . foreign editions manufactured abroad . . . would be protected by United States copyright only if a domestically-manufactured edition had been published first." (The word "only", of course, does not affect respondent's position that such foreign-manufactured books are protected.)

not in the public domain because the books manufactured in Great Britain are not offered for sale on the American market. But if petitioner is to be defeated, respondent cannot accept this view, and instead respondent has imported into the statute a non-existent provision to the effect that § 16 has no application to editions other than the first edition.

Respondent now attempts to avoid this difficulty by saying that the determination of rights in these many great works presents a "hypothetical case" which "has no pertinence here" (fn. 6, Resp. 9-10). But the issue presented by the petition is not one that can be so rigidly confined to particular facts. The question is as to the meaning of § 16, and if the section does not mean what petitioner contends, respondent must tell us what it does mean. If the works of Lewis, Hemingway, Faulkner, Dreiser and the others who have been published in Great Britain are not now in the public domain, authors and publishers must know why, and there is no third construction (different from those advanced by petitioner and, hitherto, by respondent) that can account for the result. The petitioner offers a reading of the statute that accounts for it sensibly. Up to now, respondent has rested on his opposing reading; he has not sought to avoid the problem by resorting to the deprecation of a footnote. The questions are inextricable, and we respectfully submit that respondent cannot answer by asking this Court simply to shut its eyes to a problem of this magnitude.*

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* The last sentence of respondent's footnote 6 (Resp. 10) may be contrasted with Congress' own statements on the purposes and effects of the 1909 legislation. See Committee Reports cited pet. 12 and *Washington Pub. Co.* v. *Pearson*, 306 U.S. 30.

(3)

Respondent claims that petitioner's contention "leaves the ad interim provisions without any impact at all" (Resp. 7, 10-11). The petition, urging that the ad interim provisions are, in the circumstances they describe, an alternative route to copyright, mentions that they provide "certain advantages and disadvantages" (Pet. 13). Respondent argues that petitioner has failed to show what they are. We should have thought that they would be clear to the attorneys for respondent, especially since they were spelled out in the brief submitted to the Court of Appeals (and omitted from the petition in the interests of brevity). The petition describes the origins of the ad interim provisions (Pet. 18, 1st fn.) which alone could account for their presence in the Act even if the evolution of the Act during the years 1906-1909 had ultimately deprived them of their earlier significance.* But the fact is that the ad interim provisions continued to have considerable significance, whether petitioner's or respondent's view of the statute is accepted.

As §10 was finally enacted, copyright was granted upon publication-with-notice without restriction as to where the publication might take place. But there were still important roles for §22 to play. One inhered in the publishing practices of the time. British publishers and printers did not manufacture their books with an eye to American copy-

* In addition to what appears on Pet. 18, it may be noted that in the original draft of §10, the publication-with-notice that would secure copyright had to be a publication in the United States, a restriction later abandoned (Pet. 11). Thus if the British author first published his work in England, which would be the normal situation, he could in no event secure United States copyright unless some other provision were made. Section 22 supplied this other provision.

right requirements. American publishers could be expected to have either direct familiarity with notice requirements or advice from American counsel—neither of which British publishers would have. Congress was conscious of these practical considerations. See Arguments before Committee on Patents of Senate and House on S. 6330 and H.R. 19853 (1908) at page 74, and Arguments before Committee on Patents of Senate and House on S. 6330 and H.R. 19853 (1906) at page 55. Additional evidence of this factual situation is supplied by the Copyright Office itself. See Copyright Law Revision Part 6, Supplementary Report of the Register of Copyrights on the general revision of the United States Copyright Law: 1965 Revision Bill, May 1965, pages 100-101 (" . . . foreign publishers sometimes ignore the need to use notice . . .").

In recent years §§ 22 and 23 have been given an important additional function. In 1949 and 1954 provisions were added permitting the importation of a limited number of foreign-manufactured copies if the ad interim method of securing copyright has been followed. These provisions give the publisher a chance to determine whether the work will sell in the United States before undertaking the expense of printing an edition in the United States, something he cannot do without loss of copyright if § 10 has been the source of the right.*

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* As stated by the Register of Copyrights:

". . . An ad interim copyright permits the copyright owner to import up to 1,500 copies of the foreign edition during the 5-year period of ad interim protection, so that he may test the U. S. market and determine whether it would be worthwhile to manufacture an edition in the United States. . . ." (Report of the Register, House Com. Print: 87th Cong. 1st Sess. 1961.)

But the most striking "impact" of the ad interim provisions—an impact made without regard to whether petitioner's or respondent's reading of the statute is accepted—is their effect upon § 13. Section 13 forestalls the pursuit of pirates until there has been deposit of two copies manufactured in the United States in compliance with § 16. Thus if an author rests content with publication-with-notice as his method of obtaining copyright in an English-language work first published abroad, he will have a right without a remedy until he has had an edition manufactured in the United States (an event which may never occur). If, however, he follows the more elaborate procedure prescribed by § 22, he may bring action against infringers prior to the manufacture of an American edition (and, for a period of five years, even if no American edition will ever be manufactured) since §16 contains a specific exemption where §22 has been invoked.*

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* It has been suggested (*Nimmer on Copyright*, §96.4, p. 363.2) that in the case of an English-language work first published abroad, §16 operates to prevent suit forever for infringements that occurred prior to American manufacture—that is, that the failure to manufacture here (apart from making it impossible as a practical matter to comply with the requirements of §13) means that, though copyright exists if there is the proper notice on the publication, infringers may during the earlier period proceed with impunity, the copyright being enforceable only with respect to infringements occurring after the date of American manufacture. Such a construction would of course put an author using the §10 method at a disadvantage as compared with the author using §22; the latter, exempted for five years from the requirements of §16, is in a position to sue for infringements that precede the American manufacture. This construction of §16 is not detrimental to petitioner, since in the present situation the pirates did not bring out their editions until after the American manufacture of an authorized American edition by G. P. Putnam's Sons. At the same time, this construction would require a judgment in petitioner's favor, since it necessarily posits the existence of copyright.

It may be noted, in this connection, that respondent, referring to the phrase "accorded protection" which appears in §16, makes the inaccurate statement that "Obviously, the securing of a copyright brought about by publication with notice under Section 10 affords such 'protection'." (Resp. 7.) There can be no protection unless pirates can be sued, and they cannot be sued until §13 is complied with, by the deposit of American-made copies. Copyright, we submit, is created when there is publication with notice, whether here or abroad, but the remedies available to the holder of the copyright must await the manufacture of an American edition, unless the special copyright-creating process of §22 is employed.

(4)

Respondent seeks to distinguish *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, *United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260, and *Heim* v. *Universal Pictures Co.*, 154 F.2d 480 (C.A. 2) on their facts (Resp. 9; 17, fn. 13). But these cases are not cited for their specific facts. *Washingtonian* is cited to show that the Act of 1909 represented a radical departure from the prior copyright-securing process; that the Act distinguishes between rights and remedies, and that under the new system the securing of copyright depends entirely on publication-with-notice and not at all on any action taken by or with respect to the Copyright Office. *United Dictionary* is cited for two points: (a) the principle that, unless a contrary intent is manifested, statutes are to be read as applying only to events and transactions that take place within our borders, and (b) the petitioner's alternative claim that if the 1958 French publication did not secure copyright, it was later secured by the

1964 American publication. As to the latter, respondent's attempt to distinguish the case (on the ground that "the precise question" was whether copyright once obtained was later lost through violation of the notice provisions) puts a strained meaning upon the concept of "holding", since it entirely ignores the reasoning on which the Court in *United Dictionary* based its decision. *Heim* is cited for the proposition that the copyright-securing process of §10 encompasses publication abroad as well as publication in this country—a proposition on which Judge Learned Hand, Judge Charles Clark and Judge Jerome Frank all agreed, their disagreement being on other issues not relevant to the present case.

(5)

Respondent attempts to meet the constitutional questions raised by petitioner and by *amicus* Authors League by saying that Congress could impose the condition of domestic manufacture and that §16 "by protecting domestic publishers and manufacturers from foreign competition, serves to ensure the continued health of the American publishing industry as a market for American authors" (Resp. 18). We agree that Congress has power to attach conditions that serve such a purpose. And we submit that §16 as construed by petitioner does serve the stated purpose. But §16 as construed by respondent does not. On the contrary, respondent's construction defeats the aim of protecting American printers at the same time that it deprives American authors of their copyrights (Pet. 26-27).

In attempting to dissipate the problem of Constitutional infirmity, respondent refers to a *"quid pro quo"* to justify the discrimination against American authors involved in the Office interpretation (Resp. 19). But the UCC effected

no gain for American authors in the present situation—no *quid pro quo*. Bilateral treaties which gave American authors exactly the same protection as they receive under UCC already existed with each of the countries where an English-language work by an American might possibly appear—Great Britain, France, Germany, Italy and the Scandanavian countries among others. In addition, there was the protection that as a matter of practice flowed from the provisions of the Berne Convention by reason of the usual simultaneous publication in the United States and Canada. It may be noted, moreover, that none of these foreign countries have anything equivalent to our manufacturing clause; it is not as though the foreign countries gave up restrictions upon American citizens in return for America's putting their citizens at an advantage as against American authors.

(6)

Respondent challenges petitioner's contention that the Copyright Office regulation does not represent the kind of agency interpretation to which the courts give weight and that the regulation adds nothing to the statute (Resp. 4, fn. 1). But respondent offers no answer to petitioner's points that (1) the Copyright Office has no legislative or adjudicative functions in this regard, the right of copyright flowing directly from the statute and from the author's or publisher's acts in relation to the statute; (2) the question presented by the petition is purely one of law which the statute entrusts to the courts in the first instance without any prior administrative proceeding; (3) the question is not analogous to those in which an administrative agency is invested

with responsibilities that create an administrative expertise;* (4) the regulation does not represent any contemporaneous or long-continued construction, having been adopted in 1956, long after the 1909 enactment of the statute, and embodying a reversal of earlier Copyright Office practice (Pet. 24-25). Moreover, the brief for respondent completely ignores respondent's concession in the courts below that the regulation is at least in part inconsistent with the Copyright Act. (Pet. 21-22 and fn.). A regulation that concededly conflicts with the statute is hardly a key to the meaning of the statute.

The Copyright Office position on the present question is not only specifically inconsistent with the position the Office took on the same question in the years prior to 1956; it is also inconsistent, in its rigidity, with the loose construction that the Office puts upon the manufacturing clause in its other aspects. Section 16 requires that the text of all copies "shall be printed from type set within the limits of the United States . . . or from plates made within the limits of the United States from type set therein, or, if the text be produced by lithographic process, or photoengraving process, then by a process wholly performed within the limits of

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* Respondent relies on *Bouvé* v. *Twentieth-Century Fox Film Corp.*, 122 F.2d 51, 53-54 (C.A.D.C.). This is one of a group of cases holding that in certain circumstances the Copyright Office has discretion to refuse registration. All of these cases deal with the problem, frequently faced by the Office, whether the object or article as to which registration is sought constitutes copyrightable subject matter. To some extent, of course, these cases require an interpretation of the Copyright Act, but there is an important difference of degree. In the cases cited, the question is mainly factual; a relatively narrow and confined portion of the statute is involved, and the question concerns its application to varying concrete fact-situations. In the instant case, in contrast, the facts are plain and uncontroverted, while the question of law is complex and involves the fundamental statutory structure.

the United States. . . ." Nevertheless, the Office has taken the position that there is no violation of §16 in the following situations: Type is set in a foreign country; pages are printed from the type for reproduction purposes; and the pages are brought into this country and photocopied to make up books for publication and sale in the United States. Or the overseas manufacturing process goes even further, and the photographic negatives, made from the type set abroad, are themselves made abroad and brought into the country. In such situations, the prohibitions of §16, read literally, would seem to have been violated, but the Office nevertheless issues certificates of registration. From the printers' point of view, the Copyright Office construction of the statute in these situations substantially reduces the value of the manufacturing clause and negates its purposes: books are sold on the American market though the typesetting, the most expensive and most important part of the work of manufacturing them, is done abroad. The very thing that the manufacturing clause was intended to prevent—the lessening of work available to American printers through the use of foreign labor on books that enter the American market—is promoted by the Office position. And the Office strains the language of § 16 to accomplish this result.

Conceivably, the Office does this with the notion that it is somehow aiding the preservation of the rights of authors and other copyright proprietors. In contrast, in situations like the present one, the Office strains the language of the section (by reading it as though it contained nonexistent language distinguishing between the first edition and subsequent editions) and in doing this both deprives authors of rights and diminishes the protection that the clause provides for printers (Pet. 26-27).

(7)

Petitioner and respondent differ on the significance of Congressional statements made after the enactment of the statutory provisions that are to be construed. But whatever weight such statements may carry, it can hardly be denied that they must be considered in context. Was the view that respondent ascribes to Congress critical in its consideration of the new legislation? Were the statements respondent relies on made with respect to the issue that the petition presents?

The instant case turns on the meaning of §§10 and 16. Sections 22 and 23 say nothing about whether they were meant to be exclusive or merely an alternative, and in view of the unequivocal language of §10, it would appear that they are no more than an additional route to copyright. Respondent's arguments throughout this litigation have always come ultimately to the point that, in circumstances like the present, §16 deprives the author of rights that §10 would otherwise grant. Sections 22 and 23 thus become exclusive only in the sense that the ad interim procedure is left as the single method of obtaining copyright in these circumstances (if respondent's version of §16 is correct).

But the amendments to which respondent refers, and the Congressional statements made during their consideration, have nothing to do with the question whether the ad interim provisions are exclusive, or—except as they point in a direction opposite to that suggested by respondent—with the scope or applicability of §16. These amendments merely extended the time periods that must be met if the ad interim provisions are to be invoked, and authorized the importation of 1,500 copies when they are invoked. It is not as

though the new legislation depended for its meaning or effect on a particular understanding of the existing legislation. The language quoted from *State Board of Insurance* v. *Todd Shipyards*, 370 U.S. 451 (Resp. 16) is not pertinent. No "assumption" regarding the exclusiveness *vel non* of §§22 and 23 was necessary to the legislative decision; the new provisions were equally desirable or undesirable whether petitioner's or respondent's construction of the statute is correct. Nor did Congress have to make any decision as to whether §16 distinguishes between books to be sold on the American market and books to be sold on the foreign market (as petitioner urges) or (as respondent urges) the section instead distinguishes between first editions and later editions.

But in fact the Committee Reports relied on by respondent embody a view of §16 that supports petitioner, not respondent. Senate Report No. 375, 81st Cong., 1st Sess., which respondent three times cites (Resp. 13; 13, fn. 8; 14), states (at p. 4) that "... the repeal of the manufacturing clause would result in the flooding of *the American market* with the products of cheap foreign labor." (Emphasis supplied.)

House Report No. 238, 81st Cong., 1st Sess., p. 5 (cited at Resp. 14, fn. 8; 14-15) contains the same statement, referring with the same emphasis to the American market.

The letter from the Secretary of State appended to Senate Report No. 375, p. 6 (cited at Resp. 15, fn. 10) contains the following:

> "... the various provisions of title 17 described above are clearly designed to preclude any book in the English language from having copyright protection in the

> United States unless, with a few exceptions, every copy *sold here* is manufactured in the United States." (Emphasis supplied.)

Finally, since respondent puts so much weight on retrospective comment, we ask leave to repeat the statement quoted in the petition from the House Committee Report on the copyright legislation recently considered by Congress:

> "The basic purpose of section 601, *like that of the present manufacturing clause,* is to induce the manufacture of an edition in the United States if more than a certain limited number of copies are *to be distributed in this country* . . ." (H. Rep. No. 83, 90th Cong., 1st Sess., p. 135). (Emphasis supplied.)

In sum, the parts of these Reports that respondent cites tell us only what Congress assumed the ad interim provisions to mean where the ad interim provisions are applicable. In contrast, the statements cited by petitioner tell us the meaning of the manufacturing clause, upon which the solution of the present issue depends.

Respectfully submitted,

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